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## 101 Applicable Authority

### 101.01 Statute and Rules of Practice

All proceedings before the Trademark Trial and Appeal Board (“Board”) are governed by the Lanham Trademark Act of 1946, as amended, (“Trademark Act”), 15 U.S.C. § 1051 et seq.; the rules of practice in trademark cases (commonly known as the Trademark Rules of Practice), which may be found in Parts 2 and 7 of Title 37 of the Code of Federal Regulations (“CFR”); the rules pertaining to assignments in trademark cases, which may be found in Parts 3 and 7 of 37 CFR; and the rules relating to the conduct of practitioners and the representation of others before the United States Patent and Trademark Office (“USPTO” or “Office”) which may be found in Parts 10 and 11 of 37 CFR. The USPTO rules governing procedure in inter partes proceedings before the Board are adapted, in large part, from the Federal Rules of Civil Procedure, with modifications due primarily to the administrative nature of Board proceedings. [Note 1.]

A copy of Title 37 of the CFR may be obtained at a nominal cost from the U.S. Government Printing Office. Title 37 of the CFR may also be found online at the Government Printing Office web site at: [www.gpoaccess.gov/cfr/index.html](http://www.gpoaccess.gov/cfr/index.html), or on the USPTO web site at: [www.uspto.gov/trademarks/law/index.jsp](http://www.uspto.gov/trademarks/law/index.jsp).

Information regarding proposed and final rule changes to Title 37 is also posted on the USPTO web site at [www.uspto.gov/news/index.jsp](http://www.uspto.gov/news/index.jsp).

#### NOTES:

1. *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988).

### 101.02 Federal Rules

**37 CFR § 2.122(a) Rules of Evidence.** *The rules of evidence for proceedings before the Trademark Trial and Appeal Board are the Federal Rules of Evidence, the relevant provisions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the provisions of this Part of Title 37 of the Code of Federal Regulations.*

Inter partes proceedings before the Board are also governed by the Federal Rules of Civil Procedure, except as otherwise provided in the Trademark Rules of Practice, and “wherever applicable and appropriate,” 37 CFR § 2.116(a), and by the Federal Rules of Evidence. [Note 1.]

There is no provision in the Trademark Rules of Practice concerning the applicability of the Federal Rules of Evidence to ex parte appeals before the Board. However, certain of the principles embodied in the Federal Rules of Evidence are applied by the Board, in practice, in evaluating the probative value of evidence submitted in ex parte cases. [Note 2.] See TBMP § 1208.

## NOTES:

1. 37 CFR § 2.122(a). See *Centroamericana, S.A. v. Cervceria India, Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1311 (Fed. Cir. 1989) (In applying the burden of proof provisions of Fed. R. Evid. 301, the court stated “[t]he Federal Rules of Evidence generally apply to TTAB proceedings.”). See, e.g., *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1117 (TTAB 2009) (applying Fed. R. Evid. 201); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1956 (TTAB 2008) (Fed. R. Evid. 801); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1861 (TTAB 2008) (Fed. R. Evid. 701); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1104-05 (TTAB 2007) (Fed. R. Evid. 803 and 1004); *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1264-65 (TTAB 2003) (Fed. R. Evid. 612); *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1405 (TTAB 1998) (Fed. R. Evid. 902); *HRL Assoc. Inc. v. Weiss Assoc. Inc.*, 12 USPQ2d 1819, 1822 (TTAB 1989) (Fed. R. Evid. 408); *Miles Labs. Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1448, n.20 (TTAB 1986) (Fed. R. Evid. 401).

2. See e.g., *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859, 1860 (Fed. Cir. 1987) (articles from general and business publications are not hearsay and are probative of descriptive usage); *In re Broadway Chicken, Inc.*, 38 USPQ2d 1559, 1565 (TTAB 1996) (listings from telephone directories and Dun & Bradstreet databases are not inadmissible hearsay); *In re American Olean Tile Co.*, 1 USPQ2d 1823, 1824 n.2 (TTAB 1986) (affidavit consisting of third-hand report by unidentified person is inadmissible hearsay); *In re Foundry Products, Inc.*, 193 USPQ 565 (TTAB 1976) (third-party registrations not considered when copies were not made of record).

### 101.03 Decisional Law

Proceedings before the Board are also governed, to a large extent, by precedential decisions in prior cases. These decisions include those of the Board itself, as well as the decisions of the Court of Appeals for the Federal Circuit (which determines appeals from decisions of the Board); the Court of Customs and Patent Appeals (predecessor of the Court of Appeals for the Federal Circuit); and the Director of The United States Patent and Trademark Office (formerly the Commissioner of Patents and Trademarks) (“Director”), who determines petitions seeking review of Board actions on procedural matters.

Decisions of the Board, the Director, and the Court of Appeals for the Federal Circuit appear in the United States Patents Quarterly (“USPQ”), a periodical publication of The Bureau of National Affairs, Inc., Washington, D.C. (“BNA”), and may also be found in Reed Elsevier, Inc.'s LEXIS/NEXIS legal database, and in the Intellectual Property Library of West Publishing Company's WESTLAW database. Board decisions are also available on public electronic databases at the Board home page of the USPTO web site at <http://des.uspto.gov/Foia/TTABReadingRoom.jsp> (final decisions), and at TTABVUE <http://ttabvue.uspto.gov> (docket information and full images of Board files).

Decisions that are designated by the Board “citable as precedent,” “precedent of the Board,” or “for publication in full” are citable as precedent. Decisions which are not so designated, or which

are designated for publication only in digest form, are not binding on the Board, but may be cited for whatever persuasive weight to which they may be entitled. Decisions of other tribunals may be cited to the extent allowed and for the purposes permitted by the tribunal that issued the decision. “Citation to all TTAB decisions should be to the United States Patent Quarterly, if the decision appears therein; otherwise, to a USPTO public electronic database [as listed above]. If a non-precedential decision does not appear in the United States Patents Quarterly or the USPTO's public electronic databases, the citing party should append a copy of the decision to the motion or brief in which the decision is cited.” [Note 1.]

Any cited decision of the Board or another court, which appears in the USPQ, should include a citation to the USPQ, in addition to any citation to an official reporter (if any), such as the Federal Reporter or Federal Supplement. [Note 2.] See TBMP § 801.03 (inter partes briefs); TBMP § 1203.02(f) (ex parte briefs).

#### **NOTES:**

1. *Citation of Opinions to the Trademark Trial and Appeal Board*, O.G. Notice (Jan. 23, 2007). The final decisions of the Board are posted at <http://des.uspto.gov/Foia/TTABReadingRoom.jsp> and files of Board proceedings are available at <http://ttabvue.uspto.gov/>.
2. *In re Carlson*, 91 USPQ2d 1198, 1199 (TTAB 2009) (case citations should include citation to *United States Patent Quarterly* (USPQ), if the case appears in that publication.).

### **101.04 Director’s Orders and Notices**

Occasionally, the Director or another USPTO official acting under the Director’s authority, publishes in the Official Gazette an order or notice relating to a particular Office policy, practice, procedure, or other such matter of interest to the public. Some of these orders and notices affect practice and procedure before the Board. Such notices are also posted on the Office’s web site at [www.uspto.gov/main/newsandnotices.htm](http://www.uspto.gov/main/newsandnotices.htm).

### **101.05 Trademark Trial and Appeal Board Manual of Procedure**

The Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) (this Manual) is a compilation of statutory, regulatory, and decisional authority relevant to Board practice and procedure. It is written as a guide for both the Board and practitioners. In addition to compiling applicable authority, the TBMP includes many practical suggestions on practice before the Board. Nonetheless, the TBMP “does not modify, amend, or serve as a substitute for any statutes, rules or decisional law and is not binding upon the [TTAB].” [Note 1.]

The TBMP is revised from time to time to incorporate changes in applicable statutes, rules, and case law, and to reflect changes in Board practice. [Note 2.] Practitioners consulting the TBMP should keep the publication date of the current revision in mind, and conduct any research necessary to determine whether there have been any relevant changes in the law since publication.

The TBMP is not – nor is it intended to be – a comprehensive reference on all aspects of the procedural or substantive law applicable to Board proceedings. Parties are urged to conduct appropriate legal research as needed.

#### **NOTES:**

1. *Rosenruist-Gestao E Servicos LDA v. Virgin Enters. Ltd.*, 511 F.3d 437, 85 USPQ2d 1385, 1393 (4th Cir. 2007) (quoting TBMP Introduction). *Cf. In re Sones*, 590 F.3d 1282, 93 USPQ2d 1118, 1123 (Fed. Cir. 2009) (“the TMEP is instructive, but ‘is not established law,’”) *citing In re Pennington Seed, Inc.*, 466 F.3d 1053, 80 USPQ2d 1758, 1763 (Fed. Cir. 2006) (“While the TMEP is not established law, but only provides instructions to examiners, it does represent the PTO's established policy on varietal names that is entitled to our respect.”).

2. The Board welcomes suggestions for improving the content of the TBMP. Suggestions and comments should be addressed to:

ATTN: Chief Administrative Trademark Judge  
Commissioner for Trademarks  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

## **102 Nature of Board Proceedings**

### **102.01 Jurisdiction of Board**

The Trademark Trial and Appeal Board is an administrative tribunal of the United States Patent and Trademark Office. The Board is empowered to determine only the right to register. [Note 1.]

The Board is not authorized to determine the right to use, nor may it decide broader questions of infringement or unfair competition. [Note 2.]

Similarly, the Board, being an administrative tribunal, has no authority to declare any portion of the Act of 1946, or any other act of Congress, unconstitutional. [Note 3.]

#### **NOTES:**

1. *See* Trademark Act § 17, Trademark Act § 18, Trademark Act § 20, Trademark Act § 24, 15 U.S.C. § 1067, 15 U.S.C. § 1068, 15 U.S.C. § 1070, 15 U.S.C. § 1092.

2. *FirstHealth of the Carolinas Inc. v. CareFirst of Md. Inc.*, 479 F.3d 825, 81 USPQ2d 1919, 1921 (Fed. Cir. 2007) (quoting TBMP); *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1216 (TTAB 2006) (“[T]he Board's jurisdiction is limited to determining whether trademark registrations should issue or whether registrations should be maintained; it does not have authority to determine whether a party has engaged in criminal or

civil wrongdoings.”), *aff’d unpub’d*, 240 Fed. Appx. 865 (Fed. Cir. July 11, 2007), *cert. den’d*, 552 U.S. 1109 (2008); *Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 62 USPQ2d 1857, 1858 (TTAB 2002), *aff’d*, 300 F.3d 1333, 66 USPQ2d 1811 (Fed. Cir. 2003) (no jurisdiction to decide issues arising under state dilution laws); *Person’s Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1481 (Fed. Cir. 1990) (Board cannot adjudicate unfair competition issues); *Carano v. Vina Concha Y Toro S.A.*, 67 USPQ2d 1149, 1151-52 (TTAB 2003) (no jurisdiction to determine copyright infringement; opposer's claim that applicant neither owns nor is entitled to use mark was not separable from opposer's copyright claim); *Ross v. Analytical Technology Inc.*, 51 USPQ2d 1269, 1270 n.2 (TTAB 1999) (no jurisdiction over unfair competition claims); *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1771 n.5 (TTAB 1994) (no jurisdiction over claims of trademark infringement and unfair competition), *aff’d mem.*, 108 F.3d 1392 (Fed. Cir. 1997); *Kelly Services Inc. v. Greene’s Temps. Inc.*, 25 USPQ2d 1460, 1464 (TTAB 1992) (not empowered to render declaratory judgment); *Andersen Corp. v. Therm-O-Shield Int’l, Inc.*, 226 USPQ 431, 432 n.5 (TTAB 1985) (may not entertain any claim based on Trademark Act § 43(a)); *Electronic Water Conditioners, Inc. v. Turbomag Corp.*, 221 USPQ 162, 163-64 (TTAB 1984) (unfair competition and Trademark Act § 43(a) claims are outside the Board's jurisdiction); *Hershey Foods Corp. v. Cerreta*, 195 USPQ 246, 252 (TTAB 1977) (determination of whether opposer is guilty of unfair business practices is not within the province of the Board); *Yasutomo & Co. v. Commercial Ball Pen Co.*, 184 USPQ 60, 61 (TTAB 1974) (no jurisdiction to address anti-trust issues); *American-International Travel Service, Inc. v. AITS, Inc.*, 174 USPQ 175, 179 (TTAB 1972) (no jurisdiction to determine whether opposer violated criminal statute).

*But see Loglan Institute Inc. v. Logical Language Group Inc.*, 962 F.2d 1038, 22 USPQ2d 1531, 1534 (Fed. Cir. 1992) (Board may have erred in stating that it lacked jurisdiction over equitable defenses which were based on allegations of trademark infringement and unfair competition); *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 647 (Fed. Cir. 1983) (regarding Board's authority to consider an agreement, its construction, or its validity if necessary to decide the issues properly before it, including the issue of estoppel); *Knickerbocker Toy Co. v. Faultless Starch Co.*, 467 F.2d 501, 175 USPQ 417, 423 (CCPA 1972) (Board is not precluded from passing on the validity of a copyright if it is necessary to do so in the course of the exercise of its statutory jurisdiction); *Diaz v. Servicios De Franquicia Pardo’s S.A.C.*, 83 USPQ2d 1320, 1326 (TTAB 2007) (Board has jurisdiction over assertion of priority under Article 7 of the Pan American Convention because it pertains expressly to the registrability of marks and priority rights based on use); *M-5 Steel Mfg. Inc. v. O’Hagin’s Inc.*, 61 USPQ2d 1086, 1094-95 (TTAB 2001) (contractual estoppel considered); *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701, 1702 (TTAB 2000) (noting that by rule change effective August 5, 1999, the 1946 Act was amended to allow parties to bring dilution claims under Trademark Act § 43(c) in opposition and cancellation proceedings); *British-American Tobacco Co. v. Philip Morris Inc.*, 55 USPQ2d 1585, 1589 (TTAB 2000) (a claim under Article 8 of the Pan American Convention is within the jurisdiction of the Board because it pertains expressly to the registrability of marks and provides for the cancellation of registrations).

*See also The Scotch Whiskey Association v. United States Distilled Products Co.*, 13 USPQ2d 1711, 1715 (TTAB 1989), *recon. denied*, 17 USPQ2d 1240, 1243 (TTAB 1990) (Board cannot consider claims of unfair competition standing alone, but can consider such claims in



determining the registrability of a mark, that is, in determining a separate, properly pleaded ground for opposition or cancellation), *dismissed*, 18 USPQ2d 1391, 1394 (TTAB 1991) (where petitioner did not plead a separate ground on which to base the petition to cancel, petitioner's claims under Articles 10 and 10*bis* of the Paris Convention could not be considered), *rev'd on other grounds*, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991).

3. *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1710 (TTAB 1999) (no authority to declare provisions of the Trademark Act unconstitutional nor to determine whether Trademark Act § 2(a) is overbroad or vague), *rev'd on other grounds*, 284 F. Supp. 2d 96, 68 USPQ2d 1225 (D.D.C. 2003); *Zirco Corp. v. American Tel. and Tel. Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991) (no jurisdiction to determine whether Trademark Act § 7(c), the constructive use provision, violates the commerce clause of the constitution); *Hawaiian Host, Inc. v. Rowntree MacKintosh PLC*, 225 USPQ 628, 630 (TTAB 1985) (no authority to declare Trademark Act § 44(e) unconstitutional); *Electric Storage Battery Co. v. Mine Safety Appliances Co.*, 143 USPQ 163, 167 (TTAB 1964) (no authority to find Trademark Act § 23 unconstitutional). *Cf. Capital Speakers Inc. v. Capital Speakers Club of Washington, D.C. Inc.*, 41 USPQ2d 1030, 1034 n.3 (TTAB 1996) (no authority to determine whether private activities rendered to members of private club constitute “commerce”).

## 102.02 Types of Board Proceedings

The Board has jurisdiction over four types of inter partes proceedings, namely, oppositions, cancellations, interferences, and concurrent use proceedings.

An opposition is a proceeding in which the plaintiff seeks to prevent the issuance of a registration, in whole or in part, of a mark on the Principal Register. “Any person who believes that he would be damaged by the registration of a mark” may file an opposition thereto, but the opposition may be filed only as a timely response to the publication of the mark, under Trademark Act § 12(a), 15 U.S.C. § 1062(a), in the Official Gazette of the United States Patent and Trademark Office. [Note 1.] *See* TBMP § 303 (Who May Opposer or Petition to Cancel).

A cancellation proceeding is a proceeding in which the plaintiff seeks to cancel an existing registration, in whole or in part, of a trademark on the Principal Register or the Supplemental Register. A petition for cancellation may only be filed after the issuance of the registration. A petition for cancellation may be filed by “any person who believes that he is or will be damaged by the registration” of the mark. [Note 2.] *See* TBMP § 303 (Who May Opposer or Petition to Cancel).

An interference is a proceeding in which the Board determines which, if any, of the owners of conflicting applications (or of one or more applications and one or more registrations which are in conflict), is entitled to registration. [Note 3.] The proceeding is declared by the Office only upon petition to the Director showing extraordinary circumstances therefor, that is, that the party who filed the petition would be unduly prejudiced without an interference. [Note 4.] *See* TBMP § 1002 (Declaration of Interference). Ordinarily, the availability of an opposition or cancellation proceeding is deemed to prevent any undue prejudice from the unavailability of an interference proceeding. [Note 5.] An interference that has been declared by the Director is not instituted by

the Board until after all of the marks that are to be involved in the proceeding have been published in the Official Gazette for opposition. *See* TBMP § 1003. For further information, *see* TBMP Chapter 1000 (Interferences).

A concurrent use proceeding is a proceeding in which the Board determines whether one or more applicants is entitled to a concurrent registration on the Principal Register, that is, a registration with conditions and limitations, fixed by the Board, as to the mode or place of use of the applicant's mark or the goods and/or services on or in connection with which the mark is used (usually, a concurrent registration is restricted as to the territory which it covers). *See* TBMP § 1101.01. The proceeding may be initiated only through the filing of an application for registration as a lawful concurrent user, and is instituted by the Board only after each of the one or more involved applications has been published for opposition in the Official Gazette, and all oppositions thereto (if any) have been withdrawn or dismissed. *See* TBMP § 1102.01 and TBMP § 1105. For further information, *see* TBMP Chapter 1100 (Concurrent Use Proceedings).

The Board also has jurisdiction over ex parte appeals, that is, appeals from an examining attorney's final refusal to register a mark in an application. [Note 6.] *See* TBMP Chapter 1200 (Ex Parte Appeals).

#### **NOTES:**

1. Trademark Act § 13, 15 U.S.C. § 1063.
2. Trademark Act § 14, Trademark Act § 18, Trademark Act § 24, 15 U.S.C. § 1064, 15 U.S.C. § 1068, 15 U.S.C. § 1092.
3. Trademark Act § 16, Trademark Act § 18, 15 U.S.C. § 1066, 15 U.S.C. § 1068.
4. Trademark Act § 16, 15 U.S.C. § 1066; 37 CFR § 2.91.
5. 37 CFR § 2.91(a).
6. Trademark Act § 12(b), Trademark Act § 20, 15 U.S.C. § 1062(b), 15 U.S.C. § 1070; 37 CFR § 2.141, 37 CFR § 2.142.

### **102.03 General Description of Board Proceedings**

An inter partes proceeding before the Board is similar to a civil action in a federal district court. There are pleadings (at least in an opposition or cancellation proceeding); a wide range of possible motions; conferencing; disclosures; discovery; trial; briefs; and, if requested, an oral hearing, followed by a decision on the case. [Note 1.] However, because the Board is an administrative tribunal, its rules and procedures necessarily differ in some respects from those prevailing in the federal district courts. [Note 2.] *See also* TBMP § 502.01 (Available Motions) and TBMP § 702 (Pretrial Disclosures; Manner of Trial; and Introduction of Evidence). The principal difference is that proceedings before the Board are conducted in writing, and the Board's actions in a particular case are based upon the written record therein. For example, the

Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. Indeed, a party to a proceeding before the Board need never come to the offices of the Board at all, unless the Board requests that the parties meet with the Board at its offices for a pretrial conference pursuant to 37 CFR § 2.120(i)(2), or unless the party wishes to argue its case at oral hearing (an oral hearing is held only if requested by a party to the proceeding). Parties may stipulate to expediting the proceeding in whole or in part utilizing Accelerated Case Resolution (ACR). See TBMP § 528.05(a)(2), TBMP § 702.04, and TBMP § 705.

An ex parte appeal, being appellate in nature, is a much simpler and shorter procedure, involving only the filing of briefs by the applicant and examining attorney, and, if requested by the applicant, an oral hearing. See TBMP Chapter 1200 (Ex Parte Appeals).

“The Trademark Trial and Appeal Board ... include[s] the Director, Deputy Director of the United States Patent and Trademark Office, the Commissioner for Patents, the Commissioner for Trademarks, and [the] administrative trademark judges....” [Note 3.] Interlocutory motions, requests, and other matters not actually or potentially dispositive of a proceeding may be acted upon by a single Board Administrative Trademark Judge (“judge”) or by a single interlocutory attorney (“attorney”) to whom such authority has been delegated. [Note 4.] Decisions on the merits of a case, and on complex or contested motions that are potentially dispositive of the case, are rendered by a panel of at least three Board judges. [Note 5.] Stipulations or consented (or uncontested) motions to dispose of the proceeding in a certain manner may be decided per curiam by the Board. [Note 6.] Institution orders, stipulated scheduling motions, issuance of notices of default, and other administrative matters may be acted upon by Board paralegals or may be administered through ESTTA, (Electronic System for Trademark Trials and Appeals), the Board’s electronic filing system. The parties may enter their changes of address and representation using ESTTA. For further information regarding ESTTA, see TBMP § 110.09.

#### NOTES:

1. See *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988) (USPTO rules governing the procedures are designed to approximate the proceedings in a courtroom trial).
2. See *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988); *La Maur, Inc. v. Bagwells Enter., Inc.*, 193 USPQ 234, 235 (Comm’r 1976) (“The procedures followed by the Board are not like the procedures in a courtroom and the applicability of the Federal Rules of Civil Procedure must be judged in that light....”).
3. Trademark Act § 17(b), 15 U.S.C. § 1067(b).
4. 37 CFR § 2.127(c).
5. 37 CFR § 2.129(a), 37 CFR § 2.142(e)(1).

6. See 37 CFR § 2.129(a), 37 CFR § 2.142(e)(1).

### **103 Location and Address of Board**

The Board is located at 600 Dulany Street, Alexandria, Virginia 22313-1451. The mailing address of the Board is

ATTN: Trademark Trial and Appeal Board  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451. [Note 1.]

#### **NOTES:**

1. Mail box designations (BOX TTAB) and fee notations (FEE – NO FEE) are no longer required.

### **104 Business to be Conducted in Writing**

**37 CFR § 2.191** *All business with the Office should be transacted in writing. The personal appearance of applicants or their representatives at the Office is unnecessary. The action of the Office will be based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.*

With the exceptions of discovery conferences with Board participation, see TBMP § 401.01, telephone conferences, see TBMP § 413.01 and TBMP § 502.06, all business with the Board should be transacted in writing. The personal attendance of parties or their attorneys or other authorized representatives at the offices of the Board is unnecessary, except in the case of a pretrial conference as provided in 37 CFR § 2.120(i)(2), or upon oral argument at final hearing, if a party so desires, as provided in 37 CFR § 2.129. Decisions of the Board will be based exclusively on the written record before it. [Note 1.]

#### **NOTES:**

1. Cf. *In re Sovran Fin. Corp.*, 25 USPQ2d 1537, 1538 (Comm'r 1992) (regarding actions taken by examining attorneys); *In re Merck & Co.*, 24 USPQ2d 1317, 1318 n.2 (Comm'r 1992) (regarding oral representation by Board employee); *In re Investigacion Y Desarrollo de Cosméticos S.A.*, 19 USPQ2d 1717 (Comm'r 1991).

### **105 Contact With Board Personnel**

**37 CFR § 10.93(b)** *In an adversary proceeding, including any inter partes proceeding before the Office, a practitioner shall not communicate, or cause another to communicate, as to the merits of the cause with a judge, official, or Office employee before whom the proceeding is pending, except:*

*(1) In the course of official proceedings in the cause.*

*(2) In writing if the practitioner promptly delivers a copy of the writing to opposing counsel or to the adverse party if the adverse party is not represented by a practitioner.*

*(3) Orally upon adequate notice to opposing counsel or to the adverse party if the adverse party is not represented by a practitioner.*

*(4) As otherwise authorized by law.*

Parties or their attorneys or other authorized representatives may telephone the Board to inquire about the status of a case or to ask for procedural information, but not to discuss the merits of a case or any particular issue. [Note 1.] The telephone number of the Board is (571) 272-8500, or (800) 786-9199 (toll free). If an inquiry involves a particular case, the person making the inquiry should be prepared to give the number of the proceeding or application in question. Inquiries to the Board should not be made by e-mail.

#### **NOTES:**

1. 37 CFR § 10.93(b).

## **106 Identification, Signature, and Form of Submissions**

### **106.01 Identification of Submissions**

A document filed in a proceeding before the Board should bear at its top the heading “IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD,” followed by the name and number of the inter partes proceeding (or, in the case of an ex parte appeal, or an extension of time to oppose, the application) to which it relates. [Note 1.] The document should also include a title describing its nature, e.g., “Notice of Opposition,” “Answer,” “Motion to Compel,” “Brief in Opposition to Respondent's Motion for Summary Judgment,” or “Notice of Reliance.”

Documents filed in an application which is the subject of an inter partes proceeding before the Board should be filed with the Board, and should bear at the top of the first page both the application serial number, and the inter partes proceeding number and title. Similarly, requests under Trademark Act § 7, 15 U.S.C. § 1057, to amend, correct, or surrender a registration which is the subject of a Board inter partes proceeding, and any new power of attorney, designation of domestic representative, or change of address submitted in connection with such a registration, should be filed with the Board, not with the Trademark Examining Operation, and should bear at the top of its first page both the registration number, and the inter partes proceeding number and title. [Note 2.]

#### **NOTES:**

1. 37 CFR § 2.194.

2. 37 CFR § 2.194.

## **106.02 Signature of Submissions**

**37 CFR § 2.119(e)** *Every paper filed in an inter partes proceeding, and every request for an extension of time to file an opposition, must be signed by the party filing it, or by the party's attorney or other authorized representative, but an unsigned paper will not be refused consideration if a signed copy is submitted to the Patent and Trademark Office within the time limit set in the notification of this defect by the Office.*

**37 CFR § 11.14(e)** *No individual other than those specified in paragraphs (a), (b), and (c) of this section will be permitted to practice before the Office in trademark matters on behalf of a client. Any individual may appear in a trademark or other non-patent matter in his or her own behalf. Any individual may appear in a trademark matter for:*

*(1) A firm of which he or she is a member,*

*(2) A partnership of which he or she is a partner, or*

*(3) A corporation or association of which he or she is an officer and which he or she is authorized to represent, if such firm, partnership, corporation, or association is a party to a trademark proceeding pending before the Office.*

### **37 CFR § 11.18 Signature and certificate for correspondence filed in the Office.**

*(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, and all documents filed with a hearing officer in a disciplinary proceeding, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Office must bear a signature, personally signed or inserted by such practitioner, in compliance with § 1.4(d)(1), § 1.4(d)(2), or § 2.193(a) of this chapter.*

*(b) By presenting to the Office or hearing officer in a disciplinary proceeding (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—*

*(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or knowingly and willfully makes any false, fictitious, or fraudulent statements or representations, or knowingly and willfully makes or uses any false writing or document knowing the same to contain any false, fictitious, or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001 and any other applicable criminal statute, and violations of the provisions of this section may jeopardize the probative value of the paper; and*

*(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances,*

*(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office;*

*(ii) The other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;*

*(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and*

*(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.*

*(c) Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions or actions as deemed appropriate by the USPTO Director, which may include, but are not limited to, any combination of--*

*(1) Striking the offending paper;*

*(2) Referring a practitioner's conduct to the Director of Enrollment and Discipline for appropriate action;*

*(3) Precluding a party or practitioner from submitting a paper, or presenting or contesting an issue;*

*(4) Affecting the weight given to the offending paper; or*

*(5) Terminating the proceedings in the Office.*

*(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action.*

**37 CFR § 2.193 Trademark correspondence and signature requirements.**

*(a) Signature required. Each piece of correspondence that requires a person's signature, must bear:*

*(1) A handwritten signature personally signed in permanent ink by the person named as the signatory, or a true copy thereof; or*

*(2) An electronic signature that meets the requirements of paragraph (c) of this section,*

*personally entered by the person named as the signatory. The Office will accept an electronic signature that meets the requirements of paragraph (c) of this section on correspondence filed on paper, by facsimile transmission (§ 2.195(c)), or through TEAS or ESTTA.*

*(b) Copy of original signature. If a copy, such as a photocopy or facsimile copy of an original signature is filed, the filer should retain the original as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original.*

*(c) Requirements for electronic signature. A person signing a document electronically must:*

*(1) Personally enter any combination of letters, numbers, spaces and/or punctuation marks that he or she has adopted as a signature, placed between two forward slash (“/”) symbols in the signature block on the electronic submission; or*

*(2) Sign the verified statement using some other form of electronic signature specified by the Director.*

*(d) Signatory must be identified. The name of the person who signs a document in connection with a trademark application, registration, or proceeding before the Trademark Trial and Appeal Board must be set forth in printed or typed form immediately below or adjacent to the signature, or identified elsewhere in the filing (e.g., in a cover letter or other document that accompanies the filing).*

*(e) Proper person to sign. Documents filed in connection with a trademark application or registration must be signed by a proper person.*

*\* \* \* \**

*(6) Requests for correction, amendment or surrender of registrations. A request for correction, amendment or surrender of a registration must be signed by the owner of the registration, someone with legal authority to bind the owner (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice before the Office under § 11.14 of this chapter. In the case of joint owners who are not represented by a qualified practitioner, all must sign.*

*\* \* \* \**

*(10) Cover letters. A person transmitting paper documents to the Office may sign a cover letter or transmittal letter. The Office neither requires cover letters nor questions the authority of a person who signs a communication that merely transmits paper documents.*

*(f) Signature as certification. The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any document by any person, whether a practitioner or non-practitioner, constitutes a certification under § 11.18(b) of this chapter. Violations of § 11.18(b) of this chapter may jeopardize the validity of the application or registration, and may result in the imposition of sanctions under § 11.18(c) of this chapter. Any practitioner violating § 11.18(b) may also be subject to disciplinary action. See §§ 10.23(c)(15) and 11.18(d) of this*



chapter.

\* \* \* \*

*(i) Certified documents required by statute. When a statute requires that a document be certified, a copy or facsimile transmission of the certification is not acceptable.*

Every document filed in an inter partes or ex parte proceeding before the Board, and every request for an extension of time to file an opposition, must be signed by the party filing it, or by the party's attorney or other authorized representative, as appropriate, and the signatory must be identified. [Note 1.]

Documents filed through ESTTA, the Board's electronic filing system, do not require a conventional signature. Electronic signatures pursuant to 37 CFR § 2.193(c) are required for electronic filings. The party or its representative enters a "symbol" that has been adopted as a signature. The Board will accept any combination of letters, numbers, space and/or punctuation marks as a valid signature if it is placed between two forward slash ("/") symbols. [Note 2.] For documents filed via ESTTA, the electronic signature entered on the ESTTA form is sufficient as the required signature for the entire submission. [Note 3.] The electronic filing cover sheet in ESTTA must be signed by the party filing it, the party's attorney or other authorized representative, as appropriate. For further information regarding the filing of submissions via ESTTA, *see* TBMP § 110.09.

A party may act in its own behalf in a proceeding before the Board, or an attorney or other authorized representative may represent the party. [Note 4.] *See* TBMP § 114 (Representation of a Party).

When an individual who is a party to a Board proceeding elects to act in his or her own behalf, the individual must sign any documents that he or she files with the Board. If a party which is a partnership elects to act in its own behalf, a partner should sign documents filed by the partnership. If a party which is a corporation or association elects to act in its own behalf, an officer thereof who is authorized to sign for the corporation or association should sign for that corporation or association. [Note 5.]

If a document is filed on behalf of a party by the party's attorney or other authorized representative, it must bear the signature of, and be personally signed or inserted by, that attorney or other representative, unless it is a document required to be signed personally by the party. An attorney or other authorized representative who signs a document, and then files it with the Board on behalf of a party, should remember that his or her signature to the document constitutes a certification of the elements specified in 37 CFR § 11.18(b), and that a knowing violation of the provisions of that rule by an attorney or other authorized representative will leave him or her open to disciplinary action. [Note 6.] *See* TBMP § 114.04 (regarding meaning of the designation "other authorized representative") and TBMP § 527.02 (regarding motions for Fed. R. Civ. P. 11 sanctions). A person transmitting paper documents for filing with the Board may sign a cover letter or transmittal letter, and the Office does not require the party, attorney, or authorized representative to sign a cover or transmittal letter. [Note 7.]

It is not appropriate for one person to sign a document for another person, as, for example, “John Smith, for John Doe” or “John Doe, by John Smith.” [Note 8.]

A document filed in a proceeding before the Board should include the name, in typed or printed form, of the person who signed [Note 9]; a description of the capacity in which he or she signed (e.g., as the individual who is a party, if the filing party is an individual; as a corporate officer, if the filing party is a corporation; or as the filing party's attorney); and his or her business address and telephone number. The inclusion of the signing person's address and phone number on the paper itself is vital because mail sent to the Office is opened in the Mail Room, and ordinarily the envelopes are discarded there before the mail is sent on to its ultimate destination within the Office. Thus, the Board rarely sees the return addresses on the mailing envelopes of papers filed in Board proceedings. For precisely this reason, parties are strongly encouraged to file submissions to the Board via ESTTA. *See* TBMP § 110.09.

In accordance with 37 CFR § 2.193(b), either the original of the signed document, or a legible copy thereof, may be filed with the Board. If a copy is filed, the original should be retained as evidence of authenticity. If a question as to the authenticity of a filed copy arises, the Office may require submission of the original. [Note 10.] *See* TBMP § 107 (regarding facsimile copies).

Notwithstanding the requirement that a document filed before the Board be signed, an unsigned document will not be refused consideration if a signed copy is submitted to the Board within the time limit set in the notification of this defect by the Board. [Note 11.]

#### NOTES:

1. 37 CFR § 2.193(d); 37 CFR § 2.193(e); 37 CFR § 2.119(e); and 37 CFR § 11.18(a).
2. 37 CFR § 2.102(a), 37 CFR § 2.111(b); *DaimlerChrysler Corp. v. Maydak*, 86 USPQ2d 1945, 1946 (TTAB 2008) (applicant's use of a symbol between the forward slash marks, followed by his name, qualified as a signature); *PPG Indus. Inc. v. Guardian Indus. Corp.*, 73 USPQ2d 1926, 1927 (TTAB 2005).
3. 37 CFR § 2.193(c)(1); *DaimlerChrysler Corp. v. Maydak*, 86 USPQ2d 1945, 1946 (TTAB 2008); *PPG Indus. Inc. v. Guardian Indus. Corp.*, 73 USPQ2d 1926, 1928 (TTAB 2005) (signed ESTTA notice of opposition acceptable although attached pleading was not separately signed).
4. 37 CFR § 11.14.
5. *See* 37 CFR § 11.14(e).
6. 37 CFR § 11.18. *Cf.* Fed. R. Civ. P. 11. *See also* *Clorox Co. v. Chemical Bank*, 40 USPQ2d 1098, 1100 n.9 (TTAB 1996) (accuracy in factual representations is expected). Pro se parties are also bound by 37 CFR § 11.18.
7. 37 CFR § 2.193(e)(10).

8. 37 CFR § 2.119(e) and 37 CFR § 11.18(a); *Boyds Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017 (TTAB 2003) (response to motion signed by person on behalf of practitioner is inappropriate). *Cf. Cervceria India Inc. v. Cervceria Centroamericana, S.A.*, 10 USPQ2d 1064, 1067 (TTAB 1989) (Section 8 declaration signed by someone other than named person, while perhaps unacceptable, does not constitute fraud), *aff'd Cervceria Centroamericana, S.A. v. Cervceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989).

9. 37 CFR § 2.193(d).

10. 37 CFR § 2.193(b).

11. 37 CFR § 2.119(e).

## **106.03 Form of Submissions**

### **37 CFR § 2.126 *Form of submissions to the Trademark Trial and Appeal Board.***

*(a) Submissions may be made to the Trademark Trial and Appeal Board on paper where Board practice or the rules in this part permit. A paper submission, including exhibits and depositions, must meet the following requirements:*

*(1) A paper submission must be printed in at least 11-point type and double-spaced, with the text on one side only of each sheet;*

*(2) A paper submission must be 8 to 8.5 inches (20.3 to 21.5 cm) wide and 11 to 11.69 inches (27.9 to 29.7 cm.) long, and contain no tabs or other such devices extending beyond the edges of the paper;*

*(3) If a paper submission contains dividers, the dividers must not have any extruding tabs or other devices, and must be on the same size and weight paper as the submission;*

*(4) A paper submission must not be stapled or bound;*

*(5) All pages of a paper submission must be numbered and exhibits shall be identified in the manner prescribed in § 2.123(g)(2);*

*(6) Exhibits pertaining to a paper submission must be filed on paper and comply with the requirements for a paper submission.*

*(b) Submissions may be made to the Trademark Trial and Appeal Board electronically via the Internet where the rules in this part or Board practice permit, according to the parameters established by the Board and published on the Web site of the Office. Text in an electronic submission must be in at least 11-point type and double-spaced. Exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission.*

*(c) To be handled as confidential, submissions to the Trademark Trial and Appeal Board that are confidential in whole or part pursuant to § 2.125(e) must be submitted under a separate cover. Both the submission and its cover must be marked confidential and must identify the case number and the parties. A copy of the submission with the confidential portions redacted must be submitted.*

Submissions may be made to the Board on paper or via the Internet through ESTTA, the Board's electronic filing system, as permitted by the rules or Board practice. For example, the rules provide that an opposition against a Trademark § 1 or § 44 application, or a request for extension of time to oppose a § 1 or § 44 application, may either be filed on paper or through ESTTA, but that an opposition against a Trademark Act § 66(a) application, or a request for extension of time to oppose a § 66(a) application, may only be filed through ESTTA. [Note 1.] The rules which previously permitted submissions on CD-ROM have been revoked; all submissions should now be made on paper or through ESTTA.

The requirements for each form of submission to the Board, including a confidential submission, are specified at 37 CFR § 2.126. The requirements for paper submissions are set out in part (a) of 37 CFR § 2.126. A paper submission must be 8 to 8.5 inches wide and 11 to 11.69 inches long, and printed in at least 11-point type and double-spaced, with the text on one side only of each sheet. If a paper submission contains dividers, the dividers may not contain tabs or any devices that extend beyond the edges of the paper, and must be on the same size and weight paper as the submission.

In addition, a paper submission must not be stapled or bound. This is important because all paper submissions are scanned electronically into the Board's electronic information system and removing staples or binding prior to scanning is difficult and time-consuming, especially where papers have been bound by machine. Moreover, disassembling stapled or bound papers can damage pages, resulting in jammed scanning equipment and increasing the possibility that pages will become lost or disordered during scanning. [Note 2.]

A document filed with the Board must be either the original or a legible copy thereof, on good quality paper. [Note 3.] *See also* TBMP § 107 (fax copies). Extra copies of a document should not be submitted. [Note 4.]

The requirements for electronic submissions over the Internet can be found in part (b) of 37 CFR § 2.126. Submissions over the Internet are made through ESTTA which is available on the USPTO web site. [Note 5.] Using ESTTA, a person can complete and submit forms, with attachments and/or exhibits, to the Board over the Internet, making an official filing online. ESTTA gives step-by-step instructions for properly completing a form. Available forms and instructions can be found at: <http://estta.uspto.gov>. For more information regarding ESTTA, *see* TBMP § 110.09.

The Board encourages use of ESTTA for the filing of all submissions in Board proceedings. ESTTA permits round-the-clock filing with real-time receipt confirmation, while reducing delay and the possibility of mishandling of submissions within the USPTO. Many ESTTA filings are processed automatically, with an appropriate Board order issuing within minutes of filing.

ESTTA users are strongly urged to plan ahead. Because unexpected problems can occur, users should keep filing deadlines in mind and allow plenty of time to resolve any issue which may arise. The Board will provide general assistance to ESTTA filers but cannot guarantee that any problem will be resolved prior to a deadline. Except when filing extensions of time to oppose or oppositions to Madrid Protocol applications, ESTTA filing is optional. If ESTTA filing is not possible prior to a deadline for any reason, parties should timely submit their filings on paper using another accepted filing method (e.g., certificate of mailing and Express Mail procedures). See TBMP § 110, et seq. (Certificates of Mailing), and TBMP § 111, et seq. (Express Mail).

Use of ESTTA is mandatory for the filing of either extensions of time to oppose or notices of opposition against Madrid Protocol applications, i.e., applications under Trademark Act § 66(a), 15 U.S.C. § 1141f(a). The requirement for use of ESTTA for such filings enables the USPTO to fulfill its obligation to timely notify the International Bureau of the World Intellectual Property Organization of oppositions against requests for extension of protection under the Madrid Protocol. A request for an extension of time to oppose a Madrid Protocol application which is not filed through ESTTA will be denied. Similarly, a notice of opposition not filed through ESTTA against such an application will not be instituted. [Note 6.] Once a notice of opposition is filed, subsequent submissions may be filed either on paper, or through ESTTA.

Filers may call the Board with questions about filing at (571) 272-8500 or (800) 786-9199 (toll free). Alternatively, filers may send non-urgent e-mail inquiries to [ESTTA@uspto.gov](mailto:ESTTA@uspto.gov), and include a description of the problem, the ESTTA tracking number and Board proceeding number (if any), and a telephone number for contact. The Board will respond to e-mail inquiries within two business days. The e-mail address is for technical ESTTA questions only. **Documents will not be accepted for filing by e-mail.**

Exhibits to a submission are also subject to the requirements of 37 CFR § 2.126. Exhibits pertaining to a paper submission must be filed on paper and must comply with the requirements for a paper submission. [Note 7.] Exhibits pertaining to an electronic submission must be filed electronically through ESTTA as an attachment to the submission and conform to the requirements for electronic submissions. [Note 8.] See TBMP § 110.09(c)(3) regarding size limitations.

As with any paper submission, paper exhibits may not contain tabs, dividers or any such devices that extend beyond the edges of the paper, and moreover, may not be stapled or bound. However, it is acceptable to use binder clips or rubber bands, or similar devices that would allow for easy separation of the papers for scanning.

Exhibits that are large, bulky, valuable, or breakable may be photographed or otherwise reproduced so that an appropriate paper or digitized image of the exhibits can be filed with the Board in lieu of the originals. Exhibits consisting of videotapes or audiotapes of commercials, demonstrations, etc., may not be filed electronically.

The requirements for confidential submissions are specified in 37 CFR § 2.126(c). To be handled as confidential, and kept out of the public record, submissions to the Board that are confidential must be filed under a separate cover. Both the submission and its cover must be

marked confidential and must identify the case number and the parties. A copy of the submission with the confidential portions redacted must also be submitted. [Note 9.] The Board strongly recommends that confidential materials be filed through ESTTA using the “CONFIDENTIAL” option. See TBMP § 120.02 and TBMP § 412.04 for information on filing confidential materials.

The Board, in its discretion, may refuse to enter and consider submissions which are not in compliance with 37 CFR § 2.126.

**Format of submissions.** Apart from the identification, signature, and form requirements referred to above, there is no particular format that submissions to the Board must follow. Nor does the Office have printed forms for any documents filed in Board proceedings.

#### NOTES:

1. 37 CFR § 2.101(b) (filing of oppositions); 37 CFR § 2.102(a) (filing of extensions of time to oppose).
2. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act; Final Rule, 68 Fed. Reg. 55748, 55760 (September 26, 2003).
3. 37 CFR § 2.193.
4. *DeLorme Publishing Co. v. Eartha's Inc.*, 60 USPQ2d 1222, 1222 n.1 (TTAB 2000) (papers should be filed in single copies only unless otherwise required by rule); *ITC Entertainment Group Ltd. v. Nintendo of Am. Inc.*, 45 USPQ2d 2021, 2022-23 (TTAB 1998) (unnecessary copies and attachments to motions resulted in undue delay and a waste of Board resources); *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1708 n.1 (TTAB 1994).
5. 37 CFR § 2.2(g).
6. *In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019 (TTAB 2005).
7. 37 CFR § 2.126(a)(6).
8. 37 CFR § 2.126(b).
9. 37 CFR § 2.126(c).

## 107 How and Where to File Papers and Fees

### **37 CFR § 2.195 Receipt of trademark correspondence.**

**(a) Date of receipt and Express Mail date of deposit.** Trademark correspondence received in the Office is given a filing date as of the date of receipt except as follows:

*(1) The Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for correspondence transmitted electronically under paragraph (a)(2) of this section or transmitted by facsimile under paragraph (a)(3) of this section, no correspondence is received in the Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.*

*(2) Trademark-related correspondence transmitted electronically will be given a filing date as of the date on which the Office receives the transmission.*

*(3) Correspondence transmitted by facsimile will be given a filing date as of the date on which the complete transmission is received in the Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the filing date will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.*

*(4) Correspondence filed in accordance with § 2.198 will be given a filing date as of the date of deposit as “Express Mail” with the United States Postal Service.*

***(b) Correspondence delivered by hand.*** *Correspondence may be delivered by hand during hours the Office is open to receive correspondence.*

***(c) Facsimile transmission.*** *Except in the cases enumerated in paragraph (d) of this section, correspondence, including authorizations to charge a deposit account, may be transmitted by facsimile. The receipt date accorded to the correspondence will be the date on which the complete transmission is received in the Office, unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. See § 2.196. To facilitate proper processing, each transmission session should be limited to correspondence to be filed in a single application, registration or proceeding before the Office. The application serial number, registration number, or proceeding number should be entered as a part of the sender's identification on a facsimile cover sheet.*

***(d) Facsimile transmissions are not permitted and if submitted, will not be accorded a date of receipt, in the following situations:***

*\* \* \* \**

***(3) Correspondence to be filed with the Trademark Trial and Appeal Board, except notices of ex parte appeal;***

*\* \* \* \**

***(e) Interruptions in U.S. Postal Service.***

***(1) If the Director designates a postal service interruption or emergency within the meaning of 35 U.S.C. 21(a), any person attempting to file correspondence by “Express Mail Post Office to Addressee” service who was unable to deposit the correspondence with the United States Postal***

*Service due to the interruption or emergency may petition the Director to consider such correspondence as filed on a particular date in the Office.*

**(2)** *The petition must:*

**(i)** *Be filed promptly after the ending of the designated interruption or emergency;*

**(ii)** *Include the original correspondence or a copy of the original correspondence; and*

**(iii)** *Include a statement that the correspondence would have been deposited with the United States Postal Service on the requested filing date but for the designated interruption or emergency in “Express Mail” service; and that the correspondence attached to the petition is the original correspondence or a true copy of the correspondence originally attempted to be deposited as Express Mail on the requested filing date.*

**(3)** *Paragraphs (e)(1) and (e)(2) of this section do not apply to correspondence that is excluded from the Express Mail procedure pursuant to § 2.198(a)(1).*

The Board strongly encourages electronic filing using ESTTA for all submissions in Board proceedings. However, for those documents that are being delivered to the Office, the specific requirements are set out below.

Documents relating to proceedings before the Board, may be filed during regular office hours by hand delivery or by courier service to:

Trademark Assistance Center  
James Madison Building - East Wing  
Concourse Level, Room C55  
600 Dulany Street  
Alexandria, VA 22314

Such papers may also be filed by depositing them in the mail addressed to:

ATTN: Trademark Trial and Appeal Board  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

With the exception of a notice of ex parte appeal to the Board, or in the absence of a specific request by the Board, documents to be filed with the Board may not be filed by facsimile transmission (“fax”). [Note 1.] If documents other than the notice of appeal in an ex parte appeal are filed with the Board by fax transmission, they will not receive a filing date.

However, the Board will accept, and give filing dates to, documents that had been faxed to, for example, local counsel, when the fax copies are, in turn, properly filed by other means. [Note 2.]



The Board does not accept any filings by e-mail. For information on filing submissions via ESTTA, (Electronic System for Trademark Trials and Appeals), the Board's electronic filing system, *see* TBMP § 110.09.

For information on how to pay fees, *see* TBMP § 118.

#### **NOTES:**

1. 37 CFR § 2.195(d)(3). *See e.g., Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280 (TTAB 2008) (facsimile filing of notice of opposition not accepted). A notice of ex parte appeal to the Board may be faxed to (571) 273-0059, and may include a certificate of transmission pursuant to 37 CFR § 2.197 (Certificate of mailing or transmission). Although a notice of ex parte appeal may be filed by fax, filers are strongly urged to use ESTTA for the best and most expeditious service.

2. The Board retains the discretion to explicitly direct a party to file a paper by fax in individual circumstances for the convenience of the Board. Due to the availability of electronic filing through ESTTA, however, fax filing is rarely requested by the Board. In the event the Board directs a filing by fax, the filing party will be advised of the correct telephone number to use. The filer may include a certificate of transmission pursuant to 37 CFR § 2.197 (Certificate of mailing or transmission).

### **108 Filing Receipts**

When a document intended for the Board is filed in the Office, it is possible to obtain a receipt evidencing the date of such filing.

ESTTA documents are deemed filed upon successful completion of transmission to the Board, including the receipt of any required fee. When documents are successfully filed online using ESTTA, the filer will receive an on-screen acknowledgement of the filing, including an ESTTA tracking number. The filer will also receive an e-mail filing receipt including the ESTTA tracking number. If the filer does not receive an on-screen acknowledgement and an e-mail filing receipt, it should not assume that the paper has been successfully filed. Upon filing, the cover sheet for correspondence transmitted electronically through ESTTA is automatically affixed with the date the Office receives the complete transmission. Eastern time controls the filing date. [Note 1.]

In the case of a document sent by mail, a receipt may be obtained by submitting with the document a stamped, self-addressed postcard with sufficient information to identify clearly the document, the party on whose behalf the paper is being filed, and the proceeding or application in connection with which the document is being filed. When the Office receives the document and the postcard, it will date-stamp both of them and mail the postcard back.

If a document intended for the Board is delivered by hand to the Trademark Assistance Center, *see* TBMP § 107, the receipt may take the form of a postcard bearing appropriate identifying information, or a duplicate copy of the document, or a duplicate copy of the transmittal letter

with appropriate identifying information. The receipt and the document will be date-stamped and the receipt will be handed back to the person who delivered the paper.

#### **NOTES:**

1. 37 CFR § 2.195(a)(2). See TBMP § 110.09 and <http://estta.uspto.gov> for instructions for filing via ESTTA.

## **109 Filing Date**

### **37 CFR § 2.195 Receipt of trademark correspondence.**

**(a) Date of receipt and Express Mail date of deposit.** Trademark correspondence received in the Office is given a filing date as of the date of receipt except as follows:

**(1)** The Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for correspondence transmitted electronically under paragraph (a)(2) of this section or transmitted by facsimile under paragraph (a)(3) of this section, no correspondence is received in the Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.

**(2)** Trademark-related correspondence transmitted electronically will be given a filing date as of the date on which the Office receives the transmission.

**(3)** Correspondence transmitted by facsimile will be given a filing date as of the date on which the complete transmission is received in the Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the filing date will be the next succeeding day that is not a Saturday, Sunday, or Federal holiday within the District of Columbia.

**(4)** Correspondence filed in accordance with § 2.198 will be given a filing date as of the date of deposit as “Express Mail” with the United States Postal Service.

**(b) Correspondence delivered by hand.** Correspondence may be delivered by hand during hours the Office is open to receive correspondence.

**(c) Facsimile transmission.** Except in the cases enumerated in paragraph (d) of this section, correspondence, including authorizations to charge a deposit account, may be transmitted by facsimile. The receipt date accorded to the correspondence will be the date on which the complete transmission is received in the Office, unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. See §2.196. To facilitate proper processing, each transmission session should be limited to correspondence to be filed in a single application, registration or proceeding before the Office. The application serial number, registration number, or proceeding number should be entered as a part of the sender's identification on a facsimile cover sheet.

*(d) Facsimile transmissions are not permitted and if submitted, will not be accorded a date of receipt, in the following situations:*

\* \* \* \*

*(3) Correspondence to be filed with the Trademark Trial and Appeal Board, except notices of ex parte appeal;*

\* \* \* \*

***(e) Interruptions in U.S. Postal Service.***

*(1) If the Director designates a postal service interruption or emergency within the meaning of 35 U.S.C. 21(a), any person attempting to file correspondence by “Express Mail Post Office to Addressee” service who was unable to deposit the correspondence with the United States Postal Service due to the interruption or emergency may petition the Director to consider such correspondence as filed on a particular date in the Office.*

*(2) The petition must:*

*(i) Be filed promptly after the ending of the designated interruption or emergency;*

*(ii) Include the original correspondence or a copy of the original correspondence; and*

*(iii) Include a statement that the correspondence would have been deposited with the United States Postal Service on the requested filing date but for the designated interruption or emergency in “Express Mail” service; and that the correspondence attached to the petition is the original correspondence or a true copy of the correspondence originally attempted to be deposited as Express Mail on the requested filing date.*

*(3) Paragraphs (e)(1) and (e)(2) of this section do not apply to correspondence that is excluded from the Express Mail procedure pursuant to § 2.198(a)(1)*

The cover sheet for correspondence transmitted electronically through ESTTA is automatically affixed with the date the Office receives the complete transmission, including any required fee. [Note 1.] Eastern time controls the filing date. Once a request is transmitted electronically, the system immediately provides the sender with an e-mail acknowledgement of receipt. For more information regarding ESTTA, see TBMP § 110.09.

Mailed or hand-delivered correspondence is stamped with the date of receipt in the Office (i.e., the “filing” date) unless the correspondence is filed by the “Express Mail” procedure provided in 37 CFR § 2.198. [Note 2.]

When correspondence intended for the Board is filed by the “Express Mail Post Office to Addressee” service of the United States Postal Service the document will be stamped with the “date in” as the date of receipt (unless the “date in” is a Saturday, Sunday, or Federal holiday

within the District of Columbia). If the date of deposit with the Postal Service cannot be determined, the correspondence will be stamped with the date of its actual receipt in the USPTO. [Note 3.]

If correspondence which is permitted to be filed by fax transmission to the Board is filed by that method with a certificate of transmission in accordance with 37 CFR § 2.197(a), the transmission date specified in the certificate of transmission is used for purposes of determining the timeliness of the correspondence. [Note 4.] *See* TBMP § 107. The date of receipt of the transmission, as described in 37 CFR § 2.195(a)(3), is used for all other purposes. [Note 5.]

When correspondence intended for the Board is filed by first-class mail with a certificate of mailing, in accordance with the procedure described in 37 CFR § 2.197(a), it is stamped with the date of receipt of the correspondence in the Office. The mailing date specified in the certificate of mailing is used for purposes of determining the timeliness of the correspondence. The date of receipt is used for all other purposes. [Note 6.]

#### **NOTES:**

1. 37 CFR § 2.195(a)(2); *Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280, 1282 (TTAB 2008) (receipt date of ESTTA submission is automatically affixed to paper). *See* <http://estta.uspto.gov> for instructions for filing via ESTTA.

2. 37 CFR § 2.195(a).

3. 37 CFR § 2.195 and 37 CFR § 2.198. *See* 37 CFR § 2.198(d), regarding procedures for petitioning the Director to correct a filing date discrepancy.

4. 37 CFR § 2.197(a). The only correspondence which may be filed by fax is a notice of ex parte appeal to the Board. 37 CFR § 2.195(d)(3).

5. *See* 37 CFR § 2.197(a).

6. *See* 37 CFR § 2.195(a) and 37 CFR § 2.197(a). For information concerning the date stamped by the USPTO on correspondence when interruptions or emergencies occur in the United States Postal Service, *see* 37 CFR § 2.195(e).

## **110 Certificate of Mailing Procedure and Electronic Filing Using ESTTA**

### **110.01 Certificate of Mailing – In General**

#### **37 CFR § 2.197 Certificate of mailing or transmission.**

*(a) Except in the cases enumerated in paragraph (a)(2) of this section, correspondence required to be filed in the Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.*

*(1) Correspondence will be considered as being timely filed if:*

*(i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:*

*(A) Addressed as set out in § 2.190 and deposited with the U.S. Postal Service with sufficient postage as first class mail; or*

*(B) Transmitted by facsimile to the Office in accordance with § 2.195(c); and*

*(ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.*

*(2) The procedure described in paragraph (a)(1) of this section does not apply to:*

*(i) Applications for the registration of marks under 15 U.S.C. 1051 or 1126; and*

*(ii) Madrid-related correspondence filed under § 7.11, § 7.21, § 7.14, § 7.23, § 7.24 or § 7.31.*

*(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Office, and an application is abandoned, a registration is cancelled or expired, or a proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:*

*(1) Informs the Office of the previous mailing or transmission of the correspondence within two months after becoming aware that the Office has no evidence of receipt of the correspondence;*

*(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and*

*(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.*

*(c) The Office may require additional evidence to determine whether the correspondence was timely filed.*

The certificate of mailing procedure discussed below applies only to submissions filed in paper form. For information regarding the filing of submissions via the Internet using ESTTA, see TBMP § 110.09.

Except in certain instances, specified in 37 CFR § 2.197(a), as amplified by 37 CFR § 2.195(c),

correspondence required to be filed within a set period of time will be considered as being timely filed, even though the correspondence is not received by the Office until after the expiration of the set period, if, prior to the expiration of the set period, (1) the correspondence is mailed to the Office by first-class mail, with the proper address, or (for correspondence which is permitted to be filed by fax) is transmitted to the Office by fax, in accordance with 37 CFR § 2.195(c), and (2) includes a certificate of mailing or transmission which meets the requirements specified in 37 CFR § 2.197(a). [Note 1.]

In effect, the certificate of mailing or transmission procedure permits certain types of correspondence, as specified in 37 CFR § 2.197(a) and 37 CFR § 2.195(c), to be sent to the Office by first-class mail, or by fax transmission, even on the due date for the correspondence and still be considered timely, notwithstanding the fact that the mailed correspondence will not be received in the Office until after the due date, or that the fax transmission may not, because of USPTO equipment failure or maintenance requirements, be completed until the next day. [Note 2.]

However, the Office, in its discretion, may require additional evidence to determine if correspondence which bears a certificate of mailing or a certificate of transmission was timely filed, i.e., was mailed or transmitted on the date stated in the certificate. [Note 3.]

The certificate of mailing procedure applies to the filing of all types of correspondence in Board proceedings.

The certificate of transmission procedure is available in Board proceedings only for the filing of a notice of ex parte appeal to the Board. [Note 4.] See TBMP § 107 (How and Where to File Papers and Fees).

#### NOTES:

1. 37 CFR § 2.197(a); *In re LS Bedding*, 16 USPQ2d 1451, 1452-53 (Comm'r 1990) (certificate of mailing procedure is used to determine timeliness, while the actual receipt date is used for all other purposes, such as an application filing date). See *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1734 n.2 (TTAB 2001) (no certificate of mailing).

2. See *Luemme Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758, 1759 n.1 (TTAB 1999) (motion to extend filed by a certificate of mailing dated next business day was timely where the period closed on the preceding day, a Sunday).

3. 37 CFR § 2.197(c); *S. Indus. Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1295 (TTAB 1997) (where prima facie proof of certificate of mailing is rebutted by other evidence, person signing certificate must submit an affidavit specifying the date of actual deposit); and *In re Klein*, 6 USPQ2d 1547, 1551-52 (Comm'r 1987), *aff'd sub nom. Klein v. Peterson*, 696 F. Supp. 695, 8 USPQ2d 1434 (D.D.C. 1988), *aff'd* 866 F.2d 412, 9 USPQ2d 1558 (Fed. Cir. 1989).

4. 37 CFR § 2.195(d)(3).

## 110.02 Requirements for Certificate

### ***37 CFR § 2.190 Addresses for trademark correspondence with the United States Patent and Trademark Office.***

***(a) Trademark correspondence -- in general.*** All trademark-related documents filed on paper, except documents sent to the Assignment Services Division for recordation; requests for copies of trademark documents; and certain documents filed under the Madrid Protocol as specified in paragraph (e) of this section, should be addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451. All trademark-related documents may be delivered by hand, during the hours the Office is open to receive correspondence, to the Trademark Assistance Center, James Madison Building--East Wing, Concourse Level, 600 Dulany Street, Alexandria, Virginia 22314.

***(b) Electronic trademark documents.*** An applicant may transmit a trademark document through TEAS, at <http://www.uspto.gov>.

***(c) Trademark Assignments.*** Requests to record documents in the Assignment Services Division may be filed through the Office's web site, at <http://www.uspto.gov>. Paper documents and cover sheets to be recorded in the Assignment Services Division should be addressed to: Mail Stop Assignment Recordation Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450. See § 3.27 of this chapter.

***(d) Requests for copies of trademark documents.*** Copies of trademark documents can be ordered through the Office's web site at [www.uspto.gov](http://www.uspto.gov). Paper requests for certified or uncertified copies of trademark documents should be addressed to: Mail Stop Document Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450.

***(e) Certain Documents Relating to International Applications and Registrations.*** International applications under § 7.11, subsequent designations under § 7.21, responses to notices of irregularity under § 7.14, requests to record changes in the International Register under § 7.23 and § 7.24, requests to note replacements under § 7.28, requests for transformation under § 7.31, and petitions to the Director to review an action of the Office's Madrid Processing Unit, when filed by mail, must be mailed to: Madrid Processing Unit, 600 Dulany Street, MDE-7B87, Alexandria, VA 22314-5793.

The requirements for filing trademark-related documents (except for trademark-related documents sent to the Assignment Services Division for recordation and requests for certified copies of trademark application and registration documents) by the certificate of mailing or transmission procedure are as follows:

(1). Prior to the expiration of the set period, the correspondence must be either (i) deposited with the U.S. Postal Service, with sufficient postage as first-class mail, addressed to:

ATTN: Trademark Trial and Appeal Board  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451,

or (ii) (for correspondence which is permitted to be filed by fax) transmitted to the Office by fax, in the manner described in 37 CFR § 2.195(c); and

(2). Each piece of correspondence must include a certificate which states the date of deposit or transmission, and is signed (separate and apart from any signature for the piece of correspondence itself) by a person who has a reasonable basis to expect that the correspondence will be mailed or transmitted on or before the date indicated. [Note 1.]

Trademark-related documents sent to the Assignment Services Division for recordation should be addressed to: Mail Stop Assignment Recordation Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450. If a certificate of mailing is used on such correspondence, it should specify that address. [Note 2.]

Requests for copies (certified or uncertified) of trademark documents pertaining to applications and registrations are handled by the USPTO Patent and Trademark Copy Fulfillment Branch, Public Records Division. The address for all such requests mailed to the Office is: Mail Stop Document Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450. [Note 3.] See TBMP § 121 for further information on obtaining file copies.

The Assignment Services Division of the Public Records Division also has an electronic trademark assignment recording form on the Office web site. The system is called ETAS (Electronic Trademark Assignment System) and allows customers to create and submit a Trademark Assignment Recordation Coversheet by completing on-line web forms and attaching the supporting legal documentation. The form and additional information can be accessed at [www.uspto.gov/trademarks/process/assign.jsp](http://www.uspto.gov/trademarks/process/assign.jsp). [Note 4.]

The certificate of mailing procedure may not be used for mail sent to the United States Patent and Trademark Office from a foreign country, because U.S. Postal Service first-class mail services are not available in foreign countries.

A certificate of mailing or a certificate of transmission should be clearly labeled as such and should include a reference to the proceeding number to which it pertains, the date of transmission, and the signature of the person attesting that the document is being transmitted on a certain date. When possible, the certificate should appear on the paper being transmitted, rather than on a separate sheet of paper.

## NOTES:

1. 37 CFR § 2.197(a).



2. 37 CFR § 2.190(c).

3. 37 CFR § 2.190(d).

4. 37 CFR § 2.190(c).

### **110.03 Suggested Format**

Shown below is a suggested format for a certificate of mailing, under 37 CFR § 2.197, for trademark-related mail (except for trademark-related documents sent to the Assignment Services Division for recordation and requests for certified copies of trademark application and registration documents):

#### ***Certificate of Mailing***

*I hereby certify that this correspondence  
is being deposited with the United States  
Postal Service with sufficient postage as  
First-class mail in an envelope addressed to:*

ATTN: Trademark Trial and Appeal Board  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

on \_\_\_\_\_  
Date Signature

\_\_\_\_\_  
*Typed or printed name of  
person signing certificate*

Shown below is a suggested format for a certificate of transmission under 37 CFR § 2.197:

#### ***Certificate of Transmission***

*I hereby certify that this correspondence  
is being facsimile transmitted to the United  
States Patent and Trademark Office*

on \_\_\_\_\_  
Date Signature

\_\_\_\_\_  
*Typed or printed name of  
person signing certificate*

## **110.04 Location of Certificate**

If one of the simple certificate of mailing or certificate of transmission formats shown in TBMP § 110.03 is used, it may appear on the first page of the correspondence, if feasible. Otherwise, it should appear in its entirety on the last page of the correspondence to which it pertains. If the certificate is typed, and there is not enough room on the last page to type the certificate in its entirety, it should at least be started on the last page, so that only part of it continues over to another page. The simple certificate of mailing or certificate of transmission format should never be used by itself on a separate page at the end of the correspondence. If it is, and the page becomes detached from the rest of the submission, there will be no way of determining the identity of the correspondence to which it relates, and the benefit of the certificate will be lost.

In some cases, there may not be room for a certificate of mailing or a certificate of transmission on a piece of correspondence. In such a case, the certificate may be typed on a separate sheet of paper securely attached to the correspondence.

However, the simple certificate formats shown in TBMP § 110.03 are not appropriate for use on a separate sheet of paper. Rather, a certificate placed on a separate sheet of paper must include additional information, namely, a description of the nature of the correspondence to which it pertains, as well as the identity of the application, registration, or Office proceeding in connection with which the correspondence is being filed. If there is any doubt concerning the identity of the correspondence to which a certificate of mailing or certificate of transmission on a separate sheet pertains, the certificate will not be accepted.

## **110.05 Loss of Certificate of Mailing**

If a certificate of mailing is typed on a separate sheet of paper attached to a piece of correspondence, and the certificate becomes detached, after the correspondence is filed in the Office, and does not contain identifying information sufficient to enable the Office to associate the certificate with the appropriate piece of correspondence, the Office will accept, as evidence that the certificate was filed with the specified correspondence, a postcard receipt (*see* TBMP § 108) which identifies the separate certificate of mailing sheet and the correspondence to which it was attached; accompanied by a copy of the certificate of mailing sheet as originally mailed.

## **110.06 No receipt of Correspondence Bearing Certificate**

In the event that correspondence intended for the USPTO is timely filed with an appropriate certificate of mailing or certificate of transmission, pursuant to 37 CFR § 2.197, but is not received in the Office, and there is a resulting Office action, in a proceeding or an application, which is adverse to the submitting party, the correspondence will be considered timely if the party which submitted it (1) informs the Office of the previous mailing or facsimile transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence, (2) supplies an additional copy of the previously mailed or transmitted correspondence and certificate, and (3) includes a statement attesting, on a personal knowledge basis or to the satisfaction of the Director, to the previous timely mailing or transmission. The

statement must be verified if it is made by a person other than a practitioner, as that term is defined in 37 CFR § 11.1. If the correspondence was appropriate for filing by fax transmission, a copy of the sending fax machine's report confirming transmission may be used to support the statement. *See also* TBMP § 107 (How and Where to File Papers and Fees). [Note 1.] If the document is not one authorized to be filed by facsimile transmission, the document will not be accepted. [Note 2.]

For lost or misplaced correspondence intended for the Board, the evidence required by 37 CFR § 2.197(b) should be submitted to the Board for consideration. If the requirements of 37 CFR § 2.197(b) cannot be met, the only alternative is a petition to the Director.

#### NOTES:

1. 37 CFR § 2.197(b).
2. A notice of ex parte appeal to the Board is the only document that may be filed by fax. 37 CFR § 2.195(d)(3).

### 110.07 Excluded Filings

The certificate of mailing procedure is **not** applicable to the filing of an extension of time to oppose, or a notice of opposition involving an application under Trademark Act § 66(a), 15 U.S.C. § 1141f(a). [Note 1.] The certificate of mailing procedure is applicable to all other types of paper filings in Board proceedings, including a notice of opposition; a petition to cancel; a request for an extension of time to oppose; a notice of appeal to the Board from a final refusal of registration; a notice of appeal to the Court of Appeals for the Federal Circuit from a decision of the Board; and a notice of election (in an inter partes proceeding) to proceed by civil action under Trademark Act § 21(a)(1), 15 U.S.C. § 1071(a)(1), in response to another party's appeal to the Court of Appeals for the Federal Circuit.

The certificate of transmission procedure is not applicable to any correspondence intended for the Board, except for the notice of appeal in an ex parte appeal to the Board, if sent by facsimile. [Note 2.] Neither a certificate of mailing nor a certificate of transmission is necessary or appropriate for documents filed via ESTTA. When an ESTTA filing is received by the Board, the filer will be provided with a notice that the document has been successfully filed. *See generally* TBMP § 110.09.

#### NOTES:

1. 37 CFR § 2.102(a)(2) (“A written request to extend the time for filing an opposition to an application filed under section 66(a) of the Act must be filed through ESTTA.”); 37 CFR § 2.101(b)(2) (“An opposition to an application based on section 66(a) of the Act must be filed through ESTTA.”). In addition, the certificate of mailing procedure may not be used in connection with the filing of trademark applications, 37 CFR § 2.197(a)(2)(i), and certain other Madrid-related correspondence, 37 CFR § 2.197(a)(2)(ii). *See* TMEP § 305.02(a).

2. 37 CFR § 2.195(d).

## **110.08 A Certificate of Mailing or Transmission is Not ...**

As is evident from the requirements for a certificate of mailing, specified in 37 CFR § 2.197(a), the certificate of mailing procedure is not the same as mailing by certified mail. Correspondence sent to the Board by certified mail, and not in compliance with the 37 CFR § 2.197(a) requirements for a certificate of mailing, will be stamped with the date of receipt of the correspondence in the Office, and that date will be used for all purposes, including the timeliness of the filing of the correspondence. [Note 1.]

Further, a certificate of mailing or certificate of transmission is not the equivalent of a certificate of service. A certificate of mailing or certificate of transmission indicates when correspondence was sent to the Office pursuant to the provisions of 37 CFR § 2.197(a). The mailing date recited in a certificate of mailing, or the transmission date recited in a certificate of transmission, is used for purposes of determining the timeliness of the filing of the correspondence bearing the certificate. A certificate of service, on the other hand, indicates the date when a copy of the correspondence was served upon another party. A certificate of service cannot be used to prove the timeliness of the filing of the correspondence. See TBMP § 113 for information concerning a certificate of service.

### **NOTES:**

1. See 37 CFR § 2.195 and 37 CFR § 2.197.

## **110.09 Electronic Filing Using ESTTA**

**37 CFR § 2.2(g)** *The acronym ESTTA means the Electronic System for Trademark Trials and Appeals, available at <http://www.uspto.gov/>.*

**37 CFR § 2.126(b)** *Submissions may be made to the Trademark Trial and Appeal Board electronically via the Internet where the rules in this part or Board practice permit, according to the parameters established by the Board and published on the web site of the Office. Text in an electronic submission must be in at least 11-point type and double-spaced. Exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission.*

**37 CFR § 2.101(b)(2)** *An opposition to an application based on section 66(a) of the Act must be filed through ESTTA.*

**37 CFR § 2.102(a)(2)** *A written request to extend the time for filing an opposition to an application filed under section 66(a) of the Act must be filed through ESTTA.*

ESTTA – the Electronic System for Trademark Trials and Appeals – is the Board’s electronic filing system. ESTTA is a web-based application available on the Internet. No special software (apart from a web browser) need be installed on the user’s computer. Likewise, users need not open an account or obtain a password, and there is no additional fee for use of ESTTA.

The Board strongly encourages use of ESTTA for the filing of all submissions in Board proceedings. ESTTA permits round-the-clock filing with real-time receipt confirmation, while reducing delay and the possibility of mishandling of submissions en route to or within the USPTO. Many ESTTA filings are processed automatically, with an appropriate Board order issuing within minutes of filing. Use of ESTTA helps filers avoid common (and sometimes fatal) pitfalls in filing, and allows the Board to efficiently and expeditiously process and act upon filings.

Upon completion of a successful filing, a filer using ESTTA will receive both an on-screen and e-mail acknowledgement of receipt from ESTTA with the ESTTA tracking number and the filing information including the official filing date. The filing date is the date on which the complete ESTTA filing (including any required fee) is received in the USPTO. Eastern time controls the filing date, not the local date from where the document was sent. [Note 1.] ESTTA filers should not send hard copies of electronically-filed documents to the Board.

Filers outside of the United States generally cannot receive the benefit of a certificate of mailing, 37 CFR § 2.197, or filing by Express Mail, 37 CFR § 2.198, because both provisions require deposit of the correspondence with the U.S. Postal Service. However, ESTTA provides proof of timely filing from anywhere in the world.

The ESTTA user manual, ESTTA forms, and instructions for their use can be found at <http://estta.uspto.gov/>. Contextually appropriate help is available throughout ESTTA by clicking on highlighted, hyper-linked terms. These terms usually appear in blue, but may differ depending on your browser settings. Filers should also check “What’s New in ESTTA” for important user guidelines.

This section is not intended to provide a comprehensive reference for use of ESTTA, but merely to emphasize ESTTA’s benefits and availability, and to provide some basic facts about its use.

#### **NOTES:**

1. 37 CFR § 2.195(a)(2); <http://estta.uspto.gov> (instructions for filing via ESTTA).

### **110.09(a) Plan Ahead**

ESTTA users are strongly urged to plan ahead. Because unexpected problems can occur, users should keep filing deadlines in mind and allow plenty of time to resolve any issue which may arise. [Note 1.] The Board will provide general assistance to ESTTA filers, *see* TBMP § 110.09(e) (Questions about ESTTA Filing), but cannot guarantee that any problem will be resolved prior to a deadline. Except when filing extensions of time to oppose or oppositions to Madrid Protocol applications, ESTTA filing is optional. *If ESTTA filing is not possible prior to a deadline for any reason, parties should timely submit their filings on paper, using another filing option as appropriate (e.g., certificate of mailing or Express Mail procedures).* *See* TBMP § 110 (Certificate of Mailing), and TBMP § 111 (“Express Mail” procedure). Note, however, that an extension of time to oppose, or a notice of opposition involving an application under

Trademark Act § 66(a) **must** be filed through ESTTA. [Note 2.] Users should not anticipate that the Board will extend a deadline because it was not possible to file a paper by ESTTA on the due date.

#### **NOTES:**

1. *Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280 (TTAB 2008) (ESTTA filer encountered unexpected problem in ESTTA filing; filer transmitted notice of opposition by fax. Held: ESTTA filing not received and fax filing is unacceptable; opposition dismissed as a nullity.).
2. 37 CFR § 2.102(a)(2) (extension of time to oppose) and 37 CFR § 2.101(b)(2) (notice of opposition).

### **110.09(b) ESTTA is Mandatory for Some Filings**

Use of ESTTA is optional for most papers, but is mandatory for the filing of either (1) extensions of time to oppose Madrid Protocol applications, i.e., applications under Trademark Act § 66(a), 15 U.S.C. § 1141f(a), or (2) notices of opposition against Madrid Protocol applications. [Note 1.] The requirement for use of ESTTA for such filings enables the USPTO to fulfill its obligation to timely notify the International Bureau of the World Intellectual Property Organization of oppositions against requests for extension of protection under the Madrid Protocol. A request for an extension of time to oppose a Madrid Protocol application which is not filed through ESTTA will be denied. [Note 2.] Similarly, a notice of opposition not filed through ESTTA against such an application will not be instituted. [Note 3.] Once a notice of opposition is filed, subsequent submissions may be filed either on paper, or through ESTTA, although use of ESTTA is strongly encouraged for all filings.

For a further discussion of filing notices of opposition against Madrid Protocol applications via ESTTA, *see* TBMP § 306.01.

#### **NOTES:**

1. 37 CFR § 2.102(a)(2) (extensions of time to oppose Trademark Act § 66(a), 15 U.S.C. § 1141f(a) applications must be filed through ESTTA); 37 CFR § 2.101(b)(2) (notice of opposition against Trademark Act § 66(a), 15 U.S.C. § 1141f(a) application must be filed through ESTTA). *See e.g., O.C. Seacrets Inc. v. Hotelplan Italia S.p.A.*, 95 USPQ2d 1327, 1328 n.2 (TTAB 2010) (opposition to § 66(a) application must be filed via ESTTA).
2. *In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019, 2020-21 (TTAB 2005).
3. *See In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019, 2020-21 (TTAB 2005).

## **110.09(c) Attachments to ESTTA Filings**

### **110.09(c)(1) In General**

Many ESTTA forms permit or require the filer to attach an electronic file to be transmitted to the Board as part of the filing. For instance, an ESTTA user filing a notice of opposition or petition for cancellation must attach to its filing a pleading (*i.e.*, a short and plain statement showing that the filer is entitled to relief). Likewise, a party filing a motion for summary judgment must attach a motion, as well as any affidavits or other evidence in support of it. When such a file can or must be attached, ESTTA will prompt the user to identify the file on the user's computer and attach it to the ESTTA submission. Once a file has been selected and attached, ESTTA will display its pages in "thumbnail" form, so that the user may determine whether all of the relevant pages of the selected file or files have been designated for filing.

### **110.09(c)(2) Form of ESTTA Attachments**

Attachments to ESTTA filings may be in PDF, TIFF or TXT format. [Note 1.] PDF is preferred, and should be used, if possible. Files should be formatted in letter size (8.5" x 11"), and should be rendered at 300 dpi resolution. ESTTA will accept either color or black and white PDF documents for uploading.

The filer is responsible for ensuring that all Board submissions – including attachments to ESTTA filings – are legible. Filers should be aware that the quality of ESTTA submissions is often better than those submitted in paper. [Note 2.] Problems with image quality sometimes arise when poor quality documents are scanned or when the quality of legible documents is degraded in the scanning process; these problems typically arise in documents (or parts of documents) featuring graphical material, as opposed to text. Quality can sometimes be significantly degraded when contrast settings used in scanning are not appropriate for graphical material, or when color materials are scanned or copied in black and white prior to submission. If legibility of material in color or grayscale is important, filers are urged to scan the papers in color and to adjust the scanner's contrast settings to achieve acceptable results prior to ESTTA filing. Users can check the quality of their submission in TTABVUE after filing. TTABVUE contains the same images that the Board will use in considering the submission; if the TTABVUE image is not of acceptable quality, the user should not assume that the Board will be able to view and consider it appropriately. Original paper documents are usually sent to the warehouse, and the Board works from the scanned images, rather than the originals. It will almost always be easier for the filer – who is familiar with the documents being submitted – to see that the images are suitable to the purpose for which they are being filed.

In addition, electronically submitted pleadings, motions, briefs, and the like must be formatted for at least 11-point type and be double-spaced. [Note 3.] Exhibits to pleadings, motions, and briefs need not be reformatted to meet these requirements, but must be legible.

#### **NOTES:**

1. PDF stands for Portable Document Format, a platform-independent, open standard for

document exchange. TIFF stands for Tagged Image File Format. TXT is used here to denote a plain-text file format (with .txt extension), with little or no formatting or graphics capability. TIFF and TXT files will be converted to PDF format when they are received by ESTTA. Most word processing programs can directly convert files into one of these formats. Alternatively, papers can usually be scanned in PDF or TIFF format.

2. All paper submissions are scanned by the Board upon receipt. Even when making large filings, ESTTA is preferred over paper filing.

3. 37 CFR § 2.126(b).

### **110.09(c)(3) Size Limitations**

ESTTA is suitable (and is recommended) even for large filings such as trial testimony and notices of reliance. There is no specific limit to the amount of evidence one may submit in support of a Board proceeding. However, filers should use reason and avoid the submission of irrelevant or merely cumulative evidence. The unnecessary submission of large records is a significant burden upon the Board.

Filers should, however, be aware of certain system limitations. Filers may attach one or more files to any ESTTA form that permits or requires an attachment. The size limit for each file attached is 10 MB, and the aggregate of all attached files for a single ESTTA transmission may not exceed 1 GB. However, because very large files degrade the performance of the Board's electronic file system, *filers should limit each ESTTA submission to no more than an aggregate (all attached files combined) of approximately 300 pages*. If a single submission, e.g., a single testimonial transcript or notice of reliance, is greater than 300 pages, it should be broken into two or more submissions, such that each is less than 300 pages.

### **110.09(d) Service of ESTTA Filings**

All papers filed in a Board inter partes proceeding must be served upon the other parties to the proceeding, and proof of service must be provided before the paper will be considered. [Note 1.] Many of the ESTTA forms assist the filer by including a certificate of service as part of the ESTTA submission. In all other forms, the filer must include a certificate of service as an attachment (or as part of an attachment) to the ESTTA filing.

In addition to the requirement for a certificate of service, ESTTA papers, like all other Board filings, must actually be served upon the other parties to the proceeding in the manner designated. [Note 2.] See TBMP § 2.113 (Service of Papers). ESTTA does not automatically serve papers upon opposing parties or provide notice of their filing. [Note 3.]

For a further discussion regarding the filing of a notice of opposition or a petition for cancellation via ESTTA and service requirement, see TBMP § 306.01 (notice of opposition); and TBMP § 307.01- TBMP § 307.02 (petition for cancellation).



## NOTES:

1. 37 CFR § 2.119(a).
2. *Springfield Inc. v. XD*, 86 USPQ2d 1063, 1064 (TTAB 2008) (“The proof of service requirement assumes actual service on applicant, or its attorney or domestic representative of record, if any.”). *See also* 37 CFR § 2.119(b) (acceptable means of service).
3. *Equine Touch Foundation Inc. v. Equinology Inc.*, 91 USPQ2d 1943, 1944 n.5 (TTAB 2009) (“[a]ny plaintiff who files a complaint through ESTTA is viewed by the Board as having included proof of service with its pleading. Actual forwarding of the service copy, however, is the responsibility of the filer, as ESTTA does not effect service for the filer.”); *Schott AG v. Scott*, 88 USPQ2d 1862, 1863 n.3 (TTAB 2008). *See e.g.*, *Chocoladefabriken Lindt & Sprungli AG v. Flores*, 91 USPQ 2d 1698, 1699 n.2 (TTAB 2009) (opposer filed notice of opposition via ESTTA and served copy thereof on applicant by first-class mail).

## 110.09(e) Questions About ESTTA Filing

Filers may call the Board with questions about filing at (571) 272-8500 or (800) 786-9199 (toll free) from 8:30 a.m. until 5:00 p.m. (Eastern time). Alternatively, filers may send non-urgent e-mail inquiries to [ESTTA@uspto.gov](mailto:ESTTA@uspto.gov), and include a description of the problem, the ESTTA tracking number and Board proceeding number (if any), and a telephone number for contact. The Board will respond to e-mail inquiries within two business days. The e-mail address is for technical ESTTA questions only. **Papers will not be accepted for filing by e-mail.** *See* TBMP § 107 (“The Board does not accept any filings by e-mail.”).

ESTTA users are encouraged to contact the Board when ESTTA is not working as expected. Whether or not one is able to overcome a problem, others are likely to have similar difficulties. Absent notification by users, the Board may be unaware of the problem, delaying any necessary repair.

## 111 “Express Mail” Procedure

### 111.01 In General

#### **37 CFR § 2.198 Filing of correspondence by “Express Mail.”**

*(a)(1) Except for documents listed in paragraphs (a)(1)(i) and vii) of this section, any correspondence received by the Office that was delivered by the “Express Mail Post Office to Addressee” service of the United States Postal Service (USPS) will be considered filed with the Office on the date of deposit with the USPS. The Express Mail procedure does not apply to:*

- (i) Applications for registration of marks;*
- (ii) Amendments to allege use under section 1(c) of the Act;*

*(iii) Statements of use under section 1(d) of the Act;*

*(iv) Requests for extension of time to file a statement of use under section 1(d) of the Act;*

*(v) Affidavits of continued use under section 8 of the Act;*

*(vi) Renewal requests under section 9 of the Act; and*

*(vii) Requests to change or correct addresses.*

*(2) The date of deposit with the USPS is shown by the “date-in” on the “Express Mail” label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the date of receipt in the Office as the filing date.*

*(b) Correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the “Express Mail” mailing label with the “date-in” clearly marked. Persons dealing indirectly with the employees of the USPS (such as by deposit in an “Express Mail” drop box) do so at the risk of not receiving a copy of the “Express Mail” mailing label with the desired “date-in” clearly marked. The paper(s) or fee(s) that constitute the correspondence should also include the “Express Mail” mailing label number thereon. See paragraphs (c), (d) and (e) of this section.*

*(c) Any person filing correspondence under this section that was received by the Office and delivered by the “Express Mail Post Office to Addressee” service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the “date-in” on the “Express Mail” mailing label or other official USPS notation, may petition the Director to accord the correspondence a filing date as of the “date-in” on the “Express Mail” mailing label or other official USPS notation, provided that:*

*(1) The petition is filed within two months after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;*

*(2) The number of the “Express Mail” mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing; and*

*(3) The petition includes a true copy of the “Express Mail” mailing label showing the “date-in,” and of any other official notation by the USPS relied upon to show the date of deposit.*

*(d) Any person filing correspondence under this section that was received by the Office and delivered by the “Express Mail Post Office to Addressee” service of the USPS, who can show that the “date-in” on the “Express Mail” mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Director to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:*

*(1) The petition is filed within two months after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;*

*(2) The number of the “Express Mail” mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing; and*

*(3) The petition includes a showing that establishes, to the satisfaction of the Director, that the correspondence was deposited in the “Express Mail Post Office to Addressee” service prior to the last scheduled pickup on the requested filing date. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or evidence that came into being within one business day of the deposit after the correspondence in the “Express Mail Post Office to Addressee” service of the USPS.*

*(e) If correspondence is properly addressed to the Office pursuant to § 2.190 and deposited with sufficient postage utilizing the “Express Mail Post Office to Addressee” service of the USPS, but not received by the Office, the party who mailed the correspondence may petition the Director to consider such correspondence filed in the Office on the USPS deposit date, provided that:*

*(1) The petition is filed within two months after the person becomes aware that the Office has no evidence of receipt of the correspondence*

*(2) The number of the “Express Mail” mailing label was placed on the paper(s) or fee(s) prior to the original mailing;*

*(3) The petition includes a copy of the originally deposited paper(s) or fee(s) showing the number of the “Express Mail” mailing label thereon, a copy of any returned postcard receipt, a copy of the “Express Mail” mailing label showing the “date-in,” a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the “date-in” on the “Express Mail” mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section that the correspondence was deposited in the “Express Mail Post Office to addressee” service prior to the last scheduled pickup on the requested filing date; and*

*(4) The petition includes a statement that establishes, to the satisfaction of the Director, the original deposit of the correspondence and that the copies of the correspondence, the copy of the “Express Mail” mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence, original “Express Mail” mailing label, returned postcard receipt, and official notation entered by the USPS.*

*(f) The Office may require additional evidence to determine whether the correspondence was deposited as “Express Mail” with the USPS on the date in question.*

Certain papers or fees to be filed in the Office, including any paper or fee intended for the Board, can be filed utilizing the “Express Mail Post Office to Addressee” service (not the “Express Mail Post Office to Post Office” service) of the United States Postal Service, and be considered as

having been filed in the Office on the date of deposit with the USPS. [Note 1.]

In effect, the “Express Mail” procedure permits all types of correspondence intended for the Board to be sent by the “Express Mail Post Office to Addressee” service even on the due date for the correspondence and still be considered timely, notwithstanding the fact that the mailed correspondence may not be received by the Board until after the due date. This filing procedure applies only to the “Express Mail” service of the United States Postal Service, not any third-party carrier that offers overnight delivery. [Note 2.]

**NOTES:**

1. See 37 CFR § 2.198(a)(1). See also TMEP § 305.03 for “Express Mail” procedures for the Trademark Examining Operation.
2. See *In re Pacesetter Group, Inc.*, 45 USPQ2d 1703, 1704 (Comm’r 1994) (correspondence sent by Federal Express not entitled to benefit of Express Mail procedure).

## **111.02 Requirements for “Express Mail”**

As 37 CFR § 2.198(b) provides, prior to the original mailing, the “Express Mail” mailing label number should be placed on correspondence filed thereunder. The number of the mailing label should be placed on each separate submission and each fee transmitted, either directly on the document or on a separate paper firmly and securely attached to the document.

A party that wishes to send mail to the Board by the "Express Mail" service of the U.S. Postal Service should be careful to use the "Express Mail Post Office to Addressee" service, rather than the "Express Mail Post Office to Post Office" service.

## **111.03 Questionable Date of Mailing**

If the “date-in” appearing on the “Express Mail” label is illegible, the filing date will be the actual receipt date by the USPTO. If there is a discrepancy between the filing date assigned by the Office and the date of deposit, the person who filed the correspondence may petition the Director to accord the “date-in” date by providing the evidence set forth in 37 CFR § 2.198(c), 37 CFR § 2.198(d), and 37 CFR § 2.198(e). [Note 1.]

**NOTES:**

1. See TMEP § 305.03 for further information on petition procedures.

## **112 Times for Taking Action**

***37 CFR § 2.196 Expiration on Saturday, Sunday or Federal holiday.*** *Whenever periods of time are specified in this part in days, calendar days are intended. When the day, or the last day fixed by statute or regulation by or under this part for taking any action or paying any fee in the Office falls on a Saturday, Sunday or Federal holiday within the District of Columbia, the action*

*may be taken, or the fee paid, on the next succeeding day that is not a Saturday, Sunday or a Federal holiday.*

For example, if, as set by the Board, an answer to a complaint falls due on a Saturday, Sunday, or federal holiday within the District of Columbia, an answer filed on the next business day will be considered timely. If, as set by the Board, the close of discovery falls on a Saturday, Sunday, or federal holiday within the District of Columbia, written requests for discovery (i.e., interrogatories, requests for production of documents, and requests for admission) may be served, and discovery depositions may be taken, on the next business day. Similarly, if, as set by the Board, the close of a testimony period falls on a Saturday, Sunday, or federal holiday within the District of Columbia, testimony depositions may be taken, and other evidence may be offered, on the next business day. [Note 1.]

If, because of some unscheduled event, such as adverse weather conditions, the Office is officially closed by Executive Order of the President or by the Office of Personnel Management for an entire day, that day will be regarded by the Office as a federal holiday within the District of Columbia. Any action due to be taken, or fee due to be paid, on that day, will be considered timely if the action is taken, or the fee paid, on the next succeeding business day on which the Office is open. If, because of an unscheduled event, the Office is closed for part of a business day, but is open for business for some part of the day between 8:30 a.m. and 5:00 p.m. Eastern time, any action due to be taken, or fee due to be paid, on that day remains due on that day. [Note 2.] Notification of any change in this policy, given the particular circumstances of an unscheduled event, will be posted on the Office web site at [www.uspto.gov](http://www.uspto.gov). [Note 3.] Except for maintenance and emergencies, ESTTA remains available for electronic filing of papers at all times despite official closure of the Office.

#### **NOTES:**

1. See e.g., *Nat'l Football League v. DNH Mgmt. LLC*, 85 USPQ2d 1852, 1854 n.6 (TTAB 2008) (where discovery period closed on Saturday, service of written discovery requests the following Monday was not untimely); *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1653 n.8 (TTAB 2007) (Board generally does not distinguish business days and calendar days unless last day of period is not a business day); *Strang Corp. v. Stouffer Corp.*, 16 USPQ2d 1309, 1310 (TTAB 1990) (when the five-year anniversary date of a registration falls on a weekend or holiday, petition filed on next business day is considered to have been filed within five years from the issue date).

2. See “*Filing of Papers During Unscheduled Closings of the Patent and Trademark Office*,” 1076 TMOG 6 (March 10, 1987), [www.uspto.gov/web/offices/com/sol/og/con/files/cons032.htm](http://www.uspto.gov/web/offices/com/sol/og/con/files/cons032.htm).

3. See, e.g., *Notice of USPTO Closure and Designation of September 11, 2001 under 35 U.S.C. § 21(b) for Purpose of Determining Timeliness of Actions or Fees*, [www.uspto.gov/emergencyalerts/emergencyclosure01.htm](http://www.uspto.gov/emergencyalerts/emergencyclosure01.htm).

## 113 Service of Papers

### **37 CFR § 2.119 Service and signing of papers.**

*(a) Every paper filed in the United States Patent and Trademark Office in inter partes cases, including notice of appeal, must be served upon the other parties. Proof of such service must be made before the paper will be considered by the Office. A statement signed by the attorney or other authorized representative, attached to or appearing on the original paper when filed, clearly stating the date and manner in which service was made will be accepted as prima facie proof of service.*

*(b) Service of papers must be on the attorney or other authorized representative of the party if there be such or on the party if there is no attorney or other authorized representative, and may be made in any of the following ways:*

*(1) By delivering a copy of the paper to the person served;*

*(2) By leaving a copy at the usual place of business of the person served, with someone in the person's employment;*

*(3) When the person served has no usual place of business, by leaving a copy at the person's residence, with a member of the person's family over 14 years of age and of discretion;*

*(4) Transmission by the "Express Mail Post Office to Addressee" service of the United States Postal Service or by first-class mail, which may also be certified or registered;*

*(5) Transmission by overnight courier.*

*(6) Electronic transmission when mutually agreed upon by the parties.*

*Whenever it shall be satisfactorily shown to the Director that none of the above modes of obtaining service or serving the paper is practicable, service may be by notice published in the Official Gazette.*

*(c) When service is made by first-class mail, "Express Mail," or overnight courier, the date of mailing or of delivery to the overnight courier will be considered the date of service. Whenever a party is required to take some action within a prescribed period after the service of a paper upon the party by another party and the paper is served by first-class mail, "Express Mail," or overnight courier, 5 days shall be added to the prescribed period.*

\* \* \* \*

### **113.01 Requirement for Service of Papers**

Every document filed in an inter partes proceeding before the Board, including a notice of appeal from a decision of the Board, must be served by the filing party upon every other party to the

proceeding. [Note 1.]

The requirement for service applies not only to documents filed in an inter partes proceeding before the Board, but also to documents filed in an application or registration which is the subject of such a proceeding, if the documents could have an effect on the inter partes proceeding. For example, a request to amend or correct an application or registration which is the subject of an inter partes proceeding; an abandonment of the application; or a voluntary surrender of the registration, must all be served by the defendant upon every other party to the proceeding.

#### NOTES:

1. 37 CFR § 2.119(a).

### 113.02 Requirement for Proof of Service

When a party to an inter partes proceeding before the Board files a document required by 37 CFR § 2.119(a) to be served upon every other party to the proceeding, proof that the required service has been made ordinarily must be submitted before the filing will be considered by the Board. Occasionally, in order to expedite matters, and when the interests of the other party or parties would be served thereby, the Board itself will serve, along with an action of the Board relating thereto, a copy of a document that does not include the required proof of service. For example, if an applicant in an opposition files an abandonment of its involved application without the written consent of the opposer, and the abandonment does not include proof of service upon the opposer, the Board does not send out an action stating that the abandonment will not be considered until proof of service has been submitted. Rather, the Board itself mails a copy of the abandonment to the opposer, or provides an electronic link to the TTABVUE database for the filed abandonment, along with a copy of an action by the Board entering judgment in opposer's favor pursuant to 37 CFR § 2.135 (which provides, in part, that after the commencement of an opposition, if the applicant files a written abandonment of its application or mark without the written consent of every adverse party to the proceeding, judgment shall be entered against the applicant). [Note 1.]

#### NOTES:

1. See e.g., *Central Mfg. Inc. v. Third Millennium Tech. Inc.*, 61 USPQ2d 1210, 1212 n.3 (TTAB 2001) (unserved copy of objection to further extensions of time to oppose filed prior to institution of proceeding forwarded to opposer).

### 113.03 Elements of Certificate of Service

The Board will accept, as prima facie proof that a party filing a document in a Board inter partes proceeding has served a copy of the document upon every other party to the proceeding, a statement signed by the filing party, or by its attorney or other authorized representative, clearly stating the date and manner in which service was made. The statement should also specify the name of each party or person upon whom service was made, and the address. The statement

must appear on, or be securely attached to, the document being filed. If the statement is on a separate sheet attached to the filing, it should clearly identify the submission and proceeding to which it relates. [Note 1.]

#### **NOTES:**

1. See 37 CFR § 2.119(a).

#### **Suggested Format**

Shown below is a suggested format for a certificate of service:

*I hereby certify that a true and complete copy of the foregoing (insert title of submission) has been served on (insert name of opposing counsel or party) by mailing said copy on (insert date of mailing), via First Class Mail, postage prepaid (or insert other appropriate method of delivery) to: (set out name and address of opposing counsel or party).*

---

*Signature*

#### **113.04 Manner of Service**

Service of papers filed in inter partes cases may be made in any of the ways specified in 37 CFR § 2.119(b). They are: (1) by hand delivering a copy of the submission to the person being served; (2) by leaving a copy of the submission at the usual place of business of the person being served, with someone in the person's employment; (3) when the person being served has no usual place of business, by leaving a copy of the submission at the person's address, with a member of the person's family over 14 years of age and of discretion; (4) transmission by the "Express Mail Post Office to Addressee" service of the United States Postal Service or by first-class mail, which may also be certified or registered; (5) transmission by overnight courier; and (6) electronic transmission when mutually agreed upon by the parties. In addition, whenever it is satisfactorily shown to the Director that none of the specified modes of service is practicable, service may be made by notice published in the Official Gazette of the USPTO. [Note 1.]

When service is made by mail, pursuant to 37 CFR § 2.119(b)(4), the Board considers the mailing date of the paper to be the date when the paper is deposited with the United States Postal Service, i.e., the date when custody of the paper passes to the Postal Service. As provided in 37 CFR § 2.119(a), the Board ordinarily accepts, as prima facie proof of the date of mailing, the statement signed by the filing party, or by its attorney or other authorized representative, as to the date and manner of service. However, where the prima facie proof of the certificate of service is rebutted by other evidence, and the paper would be timely served if mailed on the date specified in the certificate of service, but untimely served if not mailed until the date indicated by the rebutting evidence, the Board may request that the person who signed the certificate of service submit an affidavit specifying the date when the paper was actually deposited with the United States Postal Service.



When agreed upon by the parties, service may be made by electronic means, such as e-mail or fax. [Note 2.] The best practice is to reduce such an agreement to writing, although the agreement should not be filed with the Board unless necessary to resolve a motion.

**NOTES:**

1. 37 CFR § 2.119(b).
2. 37 CFR § 2.119(b)(6).

### **113.05 Additional Time for Taking Action After Service by Mail**

Whenever a party to an inter partes proceeding before the Board is required to take some action within a prescribed period of time after the service of a paper upon that party by another party to the proceeding, and the paper is served by first-class mail, “Express Mail, or overnight courier, the time for taking action is enlarged by 5 days. [Note 1.] The 5-day enlargement is not applicable to agreed use by parties of service by electronic transmission (i.e. e-mail or fax). [Note 2.] In addition, Fed. R. Civ. P. 6(d) is not applicable to Board proceedings.

For example, if one party to a proceeding serves, upon another party to the proceeding, a motion to compel discovery, and service of the motion is made by first-class mail, “Express Mail,” or overnight courier, the served party's time for filing a response to the motion will be 20 days from the date of service of the motion, that is, from the date of mailing or of delivery to the overnight courier. Because the service was made by first-class mail, “Express Mail,” or overnight courier, 5 days are added to the 15-day period prescribed in 37 CFR § 2.127(a) for filing a response to a motion. The additional 5 days are added to the response period before applying 37 CFR § 2.196, which addresses the response time when the last day for taking action falls on a Saturday, Sunday, or Federal holiday.

37 CFR § 2.119(c) applies only when a party has to take some action within a prescribed period after the service of a paper upon it by another party, and service of the paper was made in one of three specified ways. It does not apply to an action that must be taken by a party within a time set in a communication from the Board. Thus, for example, when a Board action notifying a defendant of the filing of an opposition or petition to cancel allows the defendant 40 days from the date of the notification in which to file an answer to the complaint, the answer is due on or before the 40th day, not on the 45th day. Similarly, the 5-day enlargement is not applicable to 37 CFR § 2.128 which sets the time for filing the briefs on the case.

**NOTES:**

1. 37 CFR § 2.119(c).
2. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42250 (August 1, 2007) (“As for agreed use by parties of email or fax for forwarding of service copies, the Office confirms that § 2.119(c) would not apply to service by electronic transmission

(e-mail or fax) under § 2.119(b)(6).”).

### **113.06 A Certificate of Service is Not...**

A certificate of service is not the equivalent of a certificate of mailing or transmission for any purpose. Cf. TBMP § 110.08.

## **114 Representation of a Party**

### **37 CFR § 11.14 *Individuals who may practice before the Office in trademark and other non-patent cases.***

**(a) Attorneys.** *Any individual who is an attorney as defined in § 11.1 may represent others before the Office in trademark and other non-patent cases. An attorney is not required to apply for registration or recognition to practice before the Office in trademark and other non-patent cases. Registration as a patent practitioner does not itself entitle an individual to practice before the Office in trademark matters.*

**(b) Non-lawyers.** *Individuals who are not attorneys are not recognized to practice before the Office in trademark and other non-patent matters, except that individuals not attorneys who were recognized to practice before the Office in trademark matters under this chapter prior to Jan. 1, 1957, will be recognized as agents to continue practice before the Office in trademark matters.*

**(c) Foreigners.** *Any foreign attorney or agent not a resident of the United States who shall file a written application for reciprocal recognition under paragraph (f) of this section and prove to the satisfaction of the OED Director that he or she is registered or in good standing before the patent or trademark office of the country in which he or she resides and practices and is possessed of good moral character and reputation, may be recognized for the limited purpose of representing parties located in such country before the Office in the presentation and prosecution of trademark matters, provided: the patent or trademark office of such country allows substantially reciprocal privileges to those permitted to practice in trademark matters before the Office. Recognition under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain.*

**(d)** *Recognition of any individual under this section shall not be construed as sanctioning or authorizing the performance of any act regarded in the jurisdiction where performed as the unauthorized practice of law.*

**(e)** *No individual other than those specified in paragraphs (a), (b), and (c) of this section will be permitted to practice before the Office in trademark matters on behalf of a client. Any individual may appear in a trademark or other non-patent matter in his or her own behalf. Any individual may appear in a trademark matter for*

**(1)** *A firm of which he or she is a member,*

**(2)** *A partnership of which he or she is a partner, or*

*(3) a corporation or association of which he or she is an officer and which he or she is authorized to represent, if such firm, partnership, corporation, or association is a party to a trademark proceeding pending before the Office.*

*(f) Application for reciprocal recognition. An individual seeking reciprocal recognition under paragraph (c) of this section, in addition to providing evidence satisfying the provisions of paragraph (c) of this section, shall apply in writing to the OED Director for reciprocal recognition, and shall pay the application fee required by § 1.21(a)(1)(i) of this subchapter.*

## **114.01 Party May Represent Itself**

A party may represent itself in an ex parte or inter partes proceeding before the Board, or the party may be represented by an attorney or other authorized representative. [Note 1.]

If a partnership which is a party to a Board proceeding elects to represent itself, the partnership may act through an individual who is a partner. If a party electing to represent itself is a corporation or an association, the party may act through any individual who is (1) an officer of the party and who is (2) in fact authorized to represent it. [Note 2.]

However, because the governing practices and procedures in proceedings before the Board are quite technical and highly specialized, it is strongly recommended that an attorney familiar with trademark law represent a party.

### **NOTES:**

1. See 37 CFR § 11.14(e).
2. 37 CFR § 11.14(e).

## **114.02 Selection of Attorney**

The Board cannot aid a party in the selection of an attorney, nor does the Office maintain a register or list of trademark attorneys. [Note 1.]

### **NOTES:**

1. 37 CFR § 2.11.

## **114.03 Representation by Attorney**

The term “attorney” is defined in 37 CFR § 11.1 as “an individual who is a member in good standing of the highest court of any State, including an individual who is in good standing of the highest court of one State and not under an order of any court or federal agency suspending, enjoining, restraining, disbaring or otherwise restricting the attorney from practice before the bar of another State or Federal agency.” An attorney is eligible to represent others before the

Office in trademark matters, including proceedings before the Board, and in other non-patent matters. [Note 1.] Such an attorney is not required to apply to the Office for registration or recognition to practice before the Office in trademark and other non-patent matters.

An attorney, as defined in 37 CFR § 11.1, will be accepted as a representative of a party in a proceeding before the Board if the attorney (1) signs a document that is filed with the Office on behalf of the party and satisfactorily identifies himself or herself as an attorney, [Note 2] (2) appears in person, or (3) files a written power of attorney signed by the party the attorney represents. [Note 3.]

When representation has been established by the filing of a document a new notice of appearance is sufficient to change the attorney of record. However, if representation has been established by the filing of a power of attorney, and thereafter another attorney or other authorized representative appears on behalf of the party, a new power of attorney is required to change the attorney of record. See TBMP § 116 (Termination of Representation), TBMP § 513 (Motion to Withdraw as Representative).

When an attorney, as defined in 37 CFR § 11.1, acting in a representative capacity signs a document or appears in person in a proceeding before the Board, his or her personal signature or appearance constitutes, inter alia, a representation to the Office that, under the provisions of 37 CFR § 11.14 (which specifies the types of individuals who may practice before the Office in trademark and other non-patent matters) and the laws of the jurisdiction where the attorney is licensed to practice that he or she is authorized to represent the particular party in whose behalf he or she acts. If there is some question as to whether an individual who makes such an appearance is authorized to act in a representative capacity, further proof of his or her authority may be required. [Note 4.]

If a formal power of attorney is filed in a proceeding before the Board, it should state the name and address of the individual or individuals to whom the power is granted, identify the party granting the power, indicate the power being granted (e.g., “to represent Opposer in this proceeding, with full power of substitution and revocation, and to transact all business in the United States Patent and Trademark Office in connection therewith”), and be signed by the party granting the power. The Office requires that a power of attorney specify the names of one or more individuals to whom the power is granted. A power that specifies both the names of one or more individuals and the name of a firm will be regarded as a power to the individual(s). [Note 5.] A power that specifies only the name of a firm will be regarded not as a power to the firm but rather simply as a designation of an address to which correspondence is to be sent. [Note 6.] See TBMP § 117 (Correspondence – With Whom Held).

## NOTES:

1. See 37 CFR § 11.1, 37 CFR § 11.14(a); *Weiffenbach v. Klempay*, 29 USPQ2d 2027, 2030 (Dep’t Comm. 1993) (only individuals who are not attorneys and were recognized to practice before the Office in trademark cases prior to January 1, 1957, and attorneys may represent clients before the Office in trademark cases).

2. *See Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1613 n.1 (TTAB 1991) (appearance made by filing motion on behalf of respondent).
3. 37 CFR § 2.17(c).
4. 37 CFR § 2.17(a).
5. *HKG Indus. Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156, 1158 (TTAB 1998) (other named attorneys appointed by petitioner were authorized to represent petitioner and assume responsibility for the case).
6. TMEP § 605.01 (Requirements for Power of Attorney).

#### **114.04 Representation by Non-lawyer (i.e., “Other Authorized Representative”)**

The only non-lawyers permitted to represent others in trademark cases before the Office, including proceedings before the Board, are those who were recognized to practice before the Office in trademark cases prior to January 1, 1957. [Note 1.] Before such a representative may take any action of any kind in a proceeding before the Board, however, the representative must file in the proceeding a written authorization from the party that he or she represents, or from another person entitled to prosecute the case (e.g., the party's appointed attorney of record). [Note 2.]

#### **NOTES:**

1. 37 CFR § 11.14(b); *Weiffenbach v. Klempay*, 29 USPQ2d 2027, 2031 (Dep't Comm. 1993) (patent agent, admitted to practice before the Office in patent cases after January 1, 1957, was excluded from practice before the Office); *Weiffenbach v. Frank*, 18 USPQ2d 1397, 1400 (consent order) (Comm'r 1991) (patent agent who engaged in unauthorized representation in trademark matters reprimanded and barred from such practice). *But see* 37 CFR § 11.14(c) and (e).
2. 37 CFR § 2.17(b).

#### **114.05 Representation by Foreign Attorney or Agent**

**37 CFR § 11.14(c) Foreigners.** *Any foreign attorney or agent not a resident of the United States who shall file a written application for reciprocal recognition under paragraph (f) of this section and prove to the satisfaction of the OED Director that he or she is registered or in good standing before the patent or trademark office of the country in which he or she resides and practices and is possessed of good moral character and reputation, may be recognized for the limited purpose of representing parties located in such country before the Office in the presentation and prosecution of trademark matters, provided: the patent or trademark office of such country allows substantially reciprocal privileges to those permitted to practice in trademark matters before the Office. Recognition under this paragraph shall continue only during the period that*

*the conditions specified in this paragraph obtain.*

**37 CFR § 11.14(f) Application for Reciprocal Recognition.** *An individual seeking reciprocal recognition under paragraph (c) of this section, in addition to providing evidence satisfying the provisions of paragraph (c) of this section, shall apply in writing to the OED Director for reciprocal recognition, and shall pay the application fee required by § 1.21(a)(1)(i) of this subchapter.*

Under certain conditions, specified in 37 CFR § 11.14(c), a foreign attorney or agent who is not a resident of the United States may be recognized for the limited purpose of representing, in trademark cases before the Office, parties located in the country in which the attorney or agent resides or practices. An individual seeking recognition to practice under 37 CFR § 11.14(c) must apply in writing to the Director of the Office of Enrollment and Discipline, and pay the appropriate fee. [Note 1.] For information on how to meet the specified conditions, contact the USPTO's Office of Enrollment and Discipline by telephone at (571) 272-4097 or by mail at Mail Stop OED, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450. When a foreign attorney is recognized to practice before the Office, the parties are reminded that the certificate of mailing procedure is not available for use on mail that originates in a foreign country

Currently, only Canada provides substantial reciprocal privileges to attorneys in the United States to practice before its trademark office. Therefore, the USPTO's Office of Enrollment and Discipline recognizes Canada as qualifying for the limited exception provided in 37 CFR § 11.14(c), permitting the Canadian attorney to represent a Canadian party before the Office. The Office of Enrollment and Discipline maintains a list of attorneys who are registered or in good standing with the Canadian Intellectual Property Office. [Note 2.]

However, the certificate of mailing procedure is not available for use on mail that originates in Canada, as it is not deposited in the United States mail as required by the certification.

#### **NOTES:**

1. 37 CFR § 11.14(f).
2. See TMEP § 602.03 (Foreign Attorneys and Agents).

### **114.06 Individual Not Entitled to Represent Others**

An individual who is not entitled, under 37 CFR § 11.14(a), 37 CFR § 11.14 (b), 37 CFR § 11.14(c), or 37 CFR § 11.14 (e) to practice before the Office in trademark cases, will not be permitted to represent a party in a proceeding before the Board. See TBMP § 114.03- TBMP § 114.05 regarding entitlement to practice before the USPTO in trademark matters.

If it comes to the attention of the Board that an individual who is not entitled, under 37 CFR § 11.14(a), 37 CFR § 11.14 (b), 37 CFR § 11.14 (c) or 37 CFR § 11.14 (d), to practice before the Office in trademark cases, is attempting to represent a client in a Board proceeding, the Board

will notify the individual that he or she is not entitled to do so. If the individual signs and files a submission on behalf of a client to a Board proceeding, the submission will not be considered unless a new copy thereof, signed by the party or by an authorized representative who is entitled to practice before the Office in trademark cases, is filed.

Moreover, no Board correspondence intended for the party will be sent to that individual. Rather, the Board will send such correspondence to the party itself, or to the party's attorney or other authorized representative entitled to practice before the Office in trademark cases. [Note 1.] See TBMP § 117 (Correspondence – With Whom Held).

#### NOTES:

1. 37 CFR § 2.18(d).

### 114.07 Designation of Domestic Representative

**37 CFR § 2.24** *Designation of representative by foreign applicant.* If an applicant is not domiciled in the United States, the applicant may designate by a document filed in the United States Patent and Trademark Office the name and address of some person resident in the United States on whom may be served notices or process in proceedings affecting the mark. If the applicant does not file a document designating the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, or if the last person designated cannot be found at the address given in the designation, then notices or process in proceedings affecting the mark may be served on the Director. The mere designation of a domestic representative does not authorize the person designated to prosecute the application unless qualified under paragraph (a), (b) or (c) of § 11.14 of this subchapter and authorized under § 2.17(b).

**37 CFR § 2.119(d)** *If a party to an inter partes proceeding is not domiciled in the United States and is not represented by an attorney or other authorized representative located in the United States, the party may designate by document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in the proceeding. If the party has appointed a domestic representative, official communications of the United States Patent and Trademark Office will be addressed to the domestic representative unless the proceeding is being prosecuted by an attorney at law or other qualified person duly authorized under § 11.14(c) of this subchapter. If the party has not appointed a domestic representative and the proceeding is not being prosecuted by an attorney at law or other qualified person, the Office will send correspondence directly to the party, unless the party designates in writing another address to which correspondence is to be sent. The mere designation of a domestic representative does not authorize the person designated to prosecute the proceeding unless qualified under § 11.14(a), or qualified under § 11.14(b) and authorized under § 2.17(b).*

Shown below is a suggested format for the designation of a domestic representative (the suggested format should appear below information identifying the proceeding in connection with which it is filed):

### ***Designation of Domestic Representative***

*(Name of Domestic Representative), whose postal address is \_\_\_\_\_*

*\_\_\_\_\_ ,  
is hereby designated (Name of Designating Party's)  
representative upon whom notice or process in this  
proceeding may be served.*

*\_\_\_\_\_  
(Signature of Designating Party)*

*\_\_\_\_\_  
(Identification of Person Signing)*

*\_\_\_\_\_  
(Date of Signature)*

Once a party has appointed a domestic representative, all correspondence in the case will be sent to the domestic representative, unless the party is represented by an attorney or other authorized representative located in the United States, or by a foreign attorney or agent duly qualified under 37 CFR § 11.14(c). See TBMP § 117.06 (Correspondence with Foreign Party).

The designation of a domestic representative is not the equivalent of a power of attorney. [Note 1.] In other words, a domestic representative cannot represent a party in Board proceedings. The appointment of a domestic representative serves a different purpose, that is to provide a contact and address for service of process. [Note 2.]

If the party has not appointed a domestic representative and the proceeding is not being prosecuted by an attorney at law or other qualified person, the Office will send correspondence directly to the party, unless the party designates in writing another address to which correspondence is to be sent. [Note 3.]

#### **NOTES:**

1. See TMEP § 610.
2. See TMEP § 610.
3. 37 CFR § 2.119(d).

### **114.08 Adverse Parties Represented by Same Practitioner**

***37 CFR § 10.66 Refusing to accept or continue employment if the interests of another client may impair the independent professional judgment of the practitioner.***

*(a) A practitioner shall decline proffered employment if the exercise of the practitioner's independent professional judgment in behalf of a client will be or is likely to be adversely*



*affected by the acceptance of the proffered employment, or if it would be likely to involve the practitioner in representing differing interests, except to the extent permitted under paragraph (c) of this section.*

*(b) A practitioner shall not continue multiple employment if the exercise of the practitioner's independent professional judgment in behalf of a client will be or is likely to be adversely affected by the practitioner's representation of another client, or if it would be likely to involve the practitioner in representing differing interests, except to the extent permitted under paragraph (c) of this section.*

*(c) In the situations covered by paragraphs (a) and (b) of this section a practitioner may represent multiple clients if it is obvious that the practitioner can adequately represent the interest of each and if each consents to the representation after full disclosure of the possible effect of such representation on the exercise of the practitioner's independent professional judgment on behalf of each.*

*(d) If a practitioner is required to decline employment or to withdraw from employment under a Disciplinary Rule, no partner, or associate, or any other practitioner affiliated with the practitioner or the practitioner's firm, may accept or continue such employment unless otherwise ordered by the Director or Commissioner.*

As a general rule, a practitioner (i.e., attorney or other authorized representative) may not represent parties with conflicting interests in proceedings before the Office. That is, a practitioner normally may not accept proffered employment, or continue multiple employment, if the exercise of the practitioner's independent professional judgment on behalf of one client is likely to be adversely affected by the practitioner's representation of another client, or if the employment would be likely to involve the practitioner in representing differing interests. [Note 1.]

However, a practitioner may represent multiple clients under the particular circumstances specified in 37 CFR § 10.66(c).

If it comes to the attention of the Board that two or more parties whose interests are in conflict appear to be represented by the same practitioner, or by different practitioners within the same firm, each of the parties and their practitioner(s) will be notified by the Board, in writing, of the possible conflict of interest.

It is the responsibility of a practitioner to ensure that there is no violation of the rules cited above. If an impermissible conflict exists, a practitioner should take appropriate action immediately. A practitioner who fails to do so may be subject to disciplinary action. [Note 2.]

#### **NOTES:**

1. 37 CFR § 10.66(a); 37 CFR § 10.66(b); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 221 USPQ 1077, 1082 (Comm'r 1984) (attorney was disqualified, but law firm was not); *Plus Products v. Con-Stan Indus., Inc.*, 221 USPQ 1071, 1075 (Comm'r 1984) (attorney representing

respondent in an opposition disqualified in view of his previous representation of petitioner in USPTO proceedings and in infringement litigation concerning the same trademark issues). *But see Gilman Corp. v. Gilman Brothers Co.*, 20 USPQ2d 1238, 1240 (Comm'r 1991) (petitioner's former attorney in patent matter not disqualified from representing respondent in trademark cancellation proceeding; no "substantial relationship" between prior and present matters); *Unico American Corp. v. Unico Banking Group*, 223 USPQ 684, 685 (Comm'r 1984) (opposer has no right to seek disqualification of applicant's counsel based on any possible conflict between applicant and third parties). *See also* Am. Bar Ass'n, MODEL RULES OF PROFESSIONAL CONDUCT, R. 1.7 (Conflict of Interest: Current Clients), 1.9 (Duties to Former Clients).

2. 37 CFR § 10.20(b).

## **115 Conduct of Practitioner**

### **115.01 Applicable Rules**

The conduct of an attorney or other authorized representative in proceedings before the Board is governed by Parts 10 and 11 of 37 CFR. Part 10 contains both Canons and Disciplinary Rules. Canons are "statements of axiomatic norms, expressing in general terms the standards of professional conduct expected of practitioners in their relationships with the public, with the legal system, and with the legal profession," while Disciplinary Rules are "mandatory in character and state the minimum level of conduct below which no practitioner can fall without being subjected to disciplinary action." [Note 1.]

Part 11 of 37 CFR addresses the representation of others before the Office, including who is authorized to practice before the United States Patent and Trademark Office (set out in 37 CFR §§ 11.4-11.18), and investigations and disciplinary proceedings (37 CFR §§ 11.19-11.61).

In addition to the requirements specifically applicable to the conduct of practitioners, all parties in matters before the Board, whether represented by counsel or not, are expected to conduct their business with decorum and courtesy. [Note 2.]

#### **NOTES:**

1. 37 CFR § 10.20.

2. 37 CFR § 2.192; *MySpace Inc. v. Mitchell*, 91 USPQ2d 1060, 1062 n.4 (TTAB 2009).

### **115.02 Disciplinary Proceedings**

**37 CFR § 2.193 Trademark correspondence and signature requirements.**

\* \* \* \*

*(c)(2) The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any document by a party, whether a practitioner or non-practitioner, constitutes a*

*certification under § 11.18(b) of this chapter. Violations of § 11.18(b)(2) of this chapter by a party, whether a practitioner or non-practitioner, may result in the imposition of sanctions under § 11.18(c) of this chapter. Any practitioner violating § 11.18(b) may also be subject to disciplinary action. See §§ 11.18(d) and 11.23(c)(15).*

**37 CFR § 11.18 Signature and certificate for correspondence filed in the Office.**

\* \* \* \*

**(b)** *By presenting to the Office or hearing officer in a disciplinary proceeding (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that-*

**(1)** *All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or knowingly and willfully makes any false, fictitious or fraudulent statements or representations, or knowingly and willfully makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. § 1001 and any other applicable criminal statute, and violations of this § may jeopardize the probative value of the paper and*

**(2)** *To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances,*

**(i)** *The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office;*

**(ii)** *The other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;*

**(iii)** *The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and*

**(iv)** *The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.*

**37 CFR § 11.20 Disciplinary sanctions; Transfer to disability inactive status.**

**(a)** *Types of discipline. The USPTO Director, after notice and opportunity for a hearing, and where grounds for discipline exist, may impose on a practitioner the following types of discipline:*

*(1) Exclusion from practice before the Office;*

*(2) Suspension from practice before the Office for an appropriate period of time;*

*(3) Reprimand or censure; or*

*(4) Probation. Probation may be imposed in lieu of or in addition to any other disciplinary sanction. Any conditions of probation shall be stated in writing in the order imposing probation. The order shall also state whether, and to what extent, the practitioner shall be required to notify clients of the probation. The order shall establish procedures for the supervision of probation. Violation of any condition of probation shall be cause for the probation to be revoked, and the disciplinary sanction to be imposed for the remainder of the probation period. Revocation of probation shall occur only after an order to show cause why probation should not be revoked is resolved adversely to the practitioner.*

*(b) Conditions imposed with discipline. When the USPTO Director imposes discipline, the practitioner may be required to make restitution either to persons financially injured by the practitioner's conduct or to an appropriate client's security trust fund, or both, as a condition of probation or of reinstatement. Such restitution shall be limited to the return of unearned practitioner fees or misappropriated client funds. Any other reasonable condition may also be imposed, including a requirement that the practitioner take and pass a professional responsibility examination.*

*(c) Transfer to disability inactive status. The USPTO Director, after notice and opportunity for a hearing may, and where grounds exist to believe a practitioner has been transferred to disability inactive status in another jurisdiction, or has been judicially declared incompetent; judicially ordered to be involuntarily committed after a hearing on the grounds of incompetency or disability, or placed by court order under guardianship or conservatorship, transfer the practitioner to disability inactive status.*

By presenting a submission to the Office, the signer makes the certifications set forth in 37 CFR § 11.18(b), and is subject to sanctions under 37 CFR § 11.18(c) for violation of 37 CFR § 11.18(b)(2), regardless of whether the party is a practitioner or non-practitioner. [Note 1.]

The rules governing disciplinary proceedings are set out in 37 CFR §§ 11.19-11.61. Such a proceeding is instituted only under the circumstances specified in 37 CFR § 11.19.

#### **NOTES:**

1. For examples of cases involving disciplined practitioners, see *Bender v. Dudas*, 490 F.3d 1361, 83 USPQ2d 1065 (Fed. Cir. 2007) (decision to exclude patent attorney from practicing before the USPTO was not “arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law” in light of attorney's failure to disclose to clients his financial relationship with invention promotion company); *Sheinbein v. Dudas*, 465 F.3d 493, 80 USPQ2d 1537 (Fed. Cir. 2006) (decision to exclude patent attorney from practicing before the USPTO was proper based on attorney's disbarment in Maryland and the District of Columbia for assisting son to flee

the United States to avoid murder investigation); *Klein v. Peterson*, 866 F.2d 412, 9 USPQ2d 1558, 1560 (Fed. Cir. 1989) (patent attorney excluded from practice for certificate of mailing violations); *Moatz v. Colitz*, 68 USPQ2d 1079 (Dir. USPTO 2003) (practitioner suspended for, *inter alia*, aiding others in the unauthorized practice of law, sharing fees with non-practitioners, and handling matter without adequate preparation); *In re Rivera*, 67 USPQ2d 1952 (Dir. USPTO 2003) (reciprocal discipline); *In re Ryznic*, 67 USPQ2d 1115 (Dir. USPTO 2003) (agent suspended for, *inter alia*, prosecuting patent application while employed by USPTO); *In re Cohen*, 66 USPQ2d 1782 (Dir. USPTO 2003) (practitioner suspended for neglecting client matter and other sanctionable conduct); *Moatz v. Kersey*, 67 USPQ2d 1291 (Dir. USPTO 2002) (practitioner represented private clients while employed by U.S. government and failed to notify USPTO of suspension in other jurisdictions); *Weiffenbach v. Logan*, 27 USPQ2d 1870, 1875 (Comm'r 1993) (patent attorney suspended from practice before USPTO for five years for altering an office action in a patent application and engaging in other unethical conduct); *McCandlish v. Doe*, 22 USPQ2d 1223, 1227 (Comm'r 1992) (patent attorney reprimanded by Commissioner for misrepresenting facts and knowingly allowing documents to remain of record which had been withdrawn).

### **115.03 Petitions to Disqualify**

**37 CFR § 11.19(c)** *Petitions to disqualify a practitioner in ex parte or inter partes cases in the Office are not governed by §§ 11.19 through 11.60 and will be handled on a case-by-case basis under such conditions as the USPTO Director deems appropriate.*

Petitions to disqualify practitioners representing parties in ex parte or inter partes cases before the Board are not disciplinary proceedings and hence are not governed by 37 CFR §§ 11.19-11.60. Rather, petitions to disqualify are handled on a case-by-case basis. See TBMP § 114.08 (Adverse Parties Represented by Same Practitioner).

When a petition to disqualify is filed in connection with a proceeding pending before the Board, the Board immediately issues an action suspending proceedings in the case and advising the parties that no additional papers should be filed by the parties until further notice, pending briefing and consideration of the petition.

For further information concerning petitions to disqualify, see TBMP § 513.02.

## **116 Termination of Representation**

### **116.01 Revocation of Authority**

**37 CFR § 2.19** *Revocation of power of attorney; withdrawal.*

*(a) Authority to represent an applicant, registrant or a party to a proceeding may be revoked at any stage in the proceedings of a case upon written notification to the Director; and when it is revoked, the Office will communicate directly with the applicant, registrant or party to the proceeding, or with the new attorney or domestic representative if one has been appointed. The Office will notify the person affected of the revocation of his or her authorization.*

Authority to represent a party in a proceeding before the Board may be revoked at any stage of the proceeding, by filing a written revocation with the Board. Thereafter, the Board will not recognize that person as a representative in the case, or give any consideration to any submissions which he or she may file therein, unless a new written authorization of that person, signed by the party, is filed in the proceeding.

## **116.02 Withdrawal as Representative--In General**

**37 CFR § 2.19(b)** *If the requirements of § 10.40 of this chapter are met, an attorney authorized under § 11.14 to represent an applicant, registrant or party in a trademark case may withdraw upon application to and approval by the Director.*

### **37 CFR § 10.40** *Withdrawal from employment.*

*(a) A practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office (see §§ 1.36 and 2.19 of this subchapter). In any event, a practitioner shall not withdraw from employment until the practitioner has taken reasonable steps to avoid foreseeable prejudice to the rights of the client, including giving due notice to his or her client, allowing time for employment of another practitioner, delivering to the client all papers and property to which the client is entitled, and complying with applicable laws and rules. A practitioner who withdraws from employment shall refund promptly any part of a fee paid in advance that has not been earned.*

*(b) **Mandatory withdrawal.** A practitioner representing a client before the Office shall withdraw from employment if:*

*(1) The practitioner knows or it is obvious that the client is bringing a legal action, commencing a proceeding before the Office, conducting a defense, or asserting a position in litigation or any proceeding pending before the Office, or is otherwise having steps taken for the client, merely for the purpose of harassing or maliciously injuring any person;*

*(2) The practitioner knows or it is obvious that the practitioner's continued employment will result in violation of a Disciplinary Rule;*

*(3) The practitioner's mental or physical condition renders it unreasonably difficult for the practitioner to carry out the employment effectively; or*

*(4) The practitioner is discharged by the client.*

*(c) **Permissive withdrawal.** If paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matters pending before the Office unless such request or such withdrawal is because:*

*(1) The petitioner's client:*

- (i) Insists upon presenting a claim or defense that is not warranted under existing law and cannot be supported by good faith argument for an extension, modification, or reversal of existing law;*
  - (ii) Personally seeks to pursue an illegal course of conduct;*
  - (iii) Insists that the practitioner pursue a course of conduct that is illegal or that is prohibited under a Disciplinary Rule;*
  - (iv) By other conduct renders it unreasonably difficult for the practitioner to carry out the employment effectively;*
  - (v) Insists, in a matter not pending before a tribunal, that the practitioner engage in conduct that is contrary to the judgment and advice of the practitioner but not prohibited under the Disciplinary Rule; or*
  - (vi) Has failed to pay one or more bills rendered by the practitioner for an unreasonable period of time or has failed to honor an agreement to pay a retainer in advance of the performance of legal services*
- (2) The practitioner's continued employment is likely to result in a violation of a Disciplinary Rule;*
- (3) The practitioner's inability to work with co-counsel indicates that the best interests of the client likely will be served by withdrawal;*
- (4) The practitioner's mental or physical condition renders it difficult for the practitioner to carry out the employment effectively;*
- (5) The practitioner's client knowingly and freely assents to termination of the employment; or*
- (6) The practitioner believes in good faith, in a proceeding pending before the Office, that the Office will find the existence of other good cause for withdrawal.*

Under certain circumstances, a practitioner may withdraw from employment as the attorney or other authorized representative of a party to a proceeding before the Board. A practitioner who wishes to withdraw must file a written request with the Board for permission to do so. The practitioner may not withdraw until he or she has complied with the conditions specified in 37 CFR § 10.40(a).

### **116.03 When Withdrawal is Mandatory**

Withdrawal from employment as the attorney or other representative of a party to a Board proceeding is mandatory under the circumstances specified in 37 CFR § 10.40(b).

## **116.04 When Withdrawal is Permissive**

Withdrawal from employment as the attorney or other authorized representative of a party to a Board proceeding is permissive under the circumstances specified in 37 CFR § 10.40(c).

## **116.05 Request to Withdraw**

A practitioner who wishes to withdraw from employment as the attorney or other authorized representative of a party to a proceeding before the Board must file a written request with the Board for permission to do so. The request to withdraw must be based upon one of the grounds for mandatory or permissive withdrawal listed in 37 CFR § 10.40(b) and 37 CFR § 10.40(c). Moreover, the practitioner must comply with the requirements of 37 CFR § 10.40(a). [Note 1.]

The propriety of a request for permission to withdraw as counsel in an application that is the subject of a potential opposition is determined by the Board, and not the trademark examining operation. *See* TBMP § 212.01.

For further information concerning the requirements for a request to withdraw as representative, and the action taken by the Board when such a request is granted, *see* TBMP § 513.01.

### **NOTES:**

1. *See* 37 CFR § 2.19(b) and 37 CFR § 10.40; *In re Slack*, 54 USPQ2d 1504, 1505 (Comm'r 2000) (standards and procedure for withdrawal); *In re Legendary Inc.*, 26 USPQ2d 1478, 1479 (Comm'r 1992) (same). *See also* *SFW Licensing Corp. v. Di Pardo Packing Ltd.*, 60 USPQ2d 1372 (TTAB 2001) (request to withdraw may not be used as a subterfuge for an extension of time; request to withdraw and motion to extend filed on last day of testimony period denied).

## **117 Correspondence - With Whom Held**

### **37 CFR § 2.18 Correspondence, with whom held.**

*(a) If an attorney transmits documents, or a written power of attorney is filed, the Office will send correspondence to the attorney transmitting the documents, or to the attorney designated in the power of attorney, provided that the attorney is an attorney as defined in § 11.1 of this chapter.*

*(b) The Office will not undertake double correspondence. If two or more attorneys appear or sign a document, the Office's reply will be sent to the address already established in the record until the applicant, registrant or party, or its duly appointed attorney, requests in writing that correspondence be sent to another address.*

*(c) If an application, registration or proceeding is not being prosecuted by an attorney but a domestic representative has been appointed, the Office will send correspondence to the domestic representative, unless the applicant, registrant or party designates in writing another correspondence address.*



*(d) If the application, registration or proceeding is not being prosecuted by an attorney and no domestic representative has been appointed, the Office will send correspondence directly to the applicant, registrant or party, unless the applicant, registrant or party designates in writing another correspondence address.*

**37 CFR § 2.24 Designation of representative by foreign applicant.**

*If an applicant is not domiciled in the United States, the applicant may designate by a document filed in the United States Patent and Trademark Office the name and address of some person resident in the United States on whom may be served notices or process in proceedings affecting the mark. If the applicant does not file a document designating the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, or if the last person designated cannot be found at the address given in the designation, then notices or process in proceedings affecting the mark may be served on the Director. The mere designation of a domestic representative does not authorize the person designated to prosecute the application unless qualified under paragraph (a), (b) or (c) of § 11.14 of this subchapter and authorized under § 2.17(b).*

**37 CFR § 2.119(d)** *If a party to an inter partes proceeding is not domiciled in the United States and is not represented by an attorney or other authorized representative located in the United States, the party may designate by document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in the proceeding. If the party has appointed a domestic representative, official communications of the United States Patent and Trademark Office will be addressed to the domestic representative unless the proceeding is being prosecuted by an attorney at law or other qualified person duly authorized under § 11.14(c) of this subchapter. If the party has not appointed a domestic representative and the proceeding is not being prosecuted by an attorney at law or other qualified person, the Office will send correspondence directly to the party, unless the party designates in writing another address to which correspondence is to be sent. The mere designation of a domestic representative does not authorize the person designated to prosecute the proceeding unless qualified under § 11.14(a), or qualified under § 11.14(b) and authorized under § 2.17(b).*

## **117.01 In General**

Whenever the Board takes an action in a proceeding before it, the Board sends a copy of the action to each party or to the party's attorney or other authorized representative. Such correspondence will be sent to the party at the party's address of record in the proceeding, unless an appearance is made on behalf of the party by an attorney (as defined in 37 CFR § 11.1), or a written power of attorney is filed, or written authorization of some other person entitled to be recognized is filed, or the party designates in writing another address to which correspondence is to be sent. If one of these events occurs, correspondence will be sent not to the party's address of record, but rather to the attorney who makes the appearance, or to the attorney designated in the power of attorney, or to the other person designated in the written authorization, or to the address designated by the party for correspondence. [Note 1.] If there is no attorney of record, but a domestic representative has been appointed, correspondence will be sent to the domestic

representative, unless the party designates in writing another correspondence address. If there is no attorney of record and no domestic representative has been appointed, correspondence will be sent directly to the party. Correspondence will continue to be sent to such address until the party, or the party's attorney or other representative, indicates in writing that correspondence is to be sent to another address. [Note 2.]

If the Board has an e-mail address for Board correspondence with a party, notice of all Board actions will be sent by e-mail. A “hard copy” may not be sent by postal mail. An e-mail address for Board correspondence will be obtained in the case of an applicant in an ex parte appeal or in an opposition if the applicant had previously supplied an e-mail address in connection with the prosecution of the subject application and had authorized the Office to communicate with applicant by e-mail. In all other cases, the Board will obtain an e-mail address for a party when that party files correspondence with the Board using ESTTA, or files a change of correspondence address specifying an e-mail address. The Board considers the submission of papers using ESTTA as consent to the Board’s sending notice of Board actions by e-mail. [Note 3.] Unlike the case with paper correspondence, a party may designate more than one e-mail address (separated by commas, up to a limit of 150 characters) for receipt of notice of Board actions.

Because notice of Board actions will not always be sent by both electronic and postal mail, it is essential that parties filing electronically with the Board adjust their e-mail “spam” filters to always accept messages from the USPTO domain (uspto.gov).

If the Board does not have an e-mail address for Board correspondence with a party, a copy of any Board action taken in the case will be sent to that party by postal mail.

The mailing of correspondence in accordance with standard Office mailing procedures creates a presumption of receipt of correspondence. [Note 4.]

#### **NOTES:**

1. See *Societe des Produits Nestle S.A. v. Basso Fedele & Figli*, 24 USPQ2d 1079, 1079-1080 (TTAB 1992) (new power of attorney filed); *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1614 n.1 (TTAB 1991) (appearance made by filing motion in the proceeding).

2. See 37 CFR § 2.18(b). See e.g., *Equine Touch Foundation Inc. v. Equinology Inc.*, 91 USPQ2d 1943, 1944 n.3 (TTAB 2009) (noting that although counsel filed an answer for respondent, the ESTTA cover sheet generated in filing the answer still listed the correspondence address as respondent rather than counsel and that “[i]f counsel intends to represent respondent throughout the remainder of this proceeding, counsel should file a change of correspondence address to list himself and his address as the address for correspondence from the Board and future service copies from petitioner.”).

3. See *Miscellaneous Changes to Trademark Trial and Appeal Board Rules*, 72 Fed. Reg. 42242, 42243-44 (August 1, 2007).

4. See *Jack Lenor Larsen Inc. v. Chas. O. Larson Co.*, 44 USPQ2d 1950, 1953 (TTAB 1997).

## **117.02 When There is More Than One Attorney or Other Authorized Representative**

If a party has supplied a list of e-mail addresses for correspondence with the Board, notice of any Board action will be sent to each of the e-mail addresses supplied (regardless of whether the listed e-mail recipients are the party's attorney(s)). *See* TBMP § 117.01.

With respect to postal mail, the Board ordinarily will not undertake double correspondence, that is, the sending of paper correspondence to two addresses on behalf of a single party. If more than one attorney or other authorized representative makes an appearance on behalf of a party, the papers filed by the additional attorney(s) or other authorized representative(s) will be accepted, but the Board will send paper correspondence to only one of them, to be determined according to the circumstances in the case. [Note 1.]

If a power of attorney names more than one individual, and does not specify which of them is to have primary responsibility for the case and receive correspondence, the name(s) of the individual attorney(s) in the signature block of the covering transmittal letter will be used by the Board on the proceeding file, on correspondence for the party, and on the final decision of the Board, to identify counsel for the party, unless the party or one of the named attorneys requests otherwise in writing. If there is no transmittal letter, and no other indication as to which of the named attorneys is to have primary responsibility for the case and receive correspondence, the name of the first listed attorney will be used by the Board on the proceeding file, in the Board's electronic databases (e.g., TTABVue), on correspondence for the party, and on the Board's final decision, unless the party or one of the named attorneys requests otherwise in writing.

If a power of attorney from a party to one attorney ("A") has been filed, and thereafter another attorney or other authorized representative ("B") makes an appearance on behalf of the party and files a written request that correspondence be sent to him or her, B ordinarily will be required to submit authorization, from the party or from A, for the requested change in the correspondence address. However, if B's request for change of correspondence address bears proof of service of a copy thereof upon both the party and A, and neither files an objection to the request, the correspondence address will be changed, and future correspondence will be sent to B, rather than to A.

For example, if one attorney or other authorized representative ("A") makes an appearance on behalf of a party, and his or her address is thus established in the proceeding file as the correspondence address, following which a second attorney or other authorized representative ("B") makes an appearance on behalf of the party, and files a written request that correspondence be sent to him or her, the correspondence address in the proceeding file will be changed, and future correspondence will be sent to B, rather than A. No requirement will be made that B submit authorization, from the party or from A, for the change of correspondence address, nor will B be required to serve a copy of the request upon A. If B does not file a written request that correspondence be sent to him or her, correspondence will continue to be sent to A.

If a power of attorney from a party to one attorney ("A") has been filed, and thereafter a power of attorney from the party to another attorney ("B") is filed, the second power of attorney will be

construed, even if there is no revocation of the first power, as a written request to change the correspondence address from A to B, unless the party or A directs otherwise. [Note 2.]

Likewise, if an attorney makes an appearance on behalf of a party, and thereafter the party files a written power of attorney to another attorney, the Board will send subsequent correspondence to the appointed attorney.

If a power of attorney from a party to one attorney (“A”) has been filed, and thereafter A files an “associate power of attorney” to another attorney (“B”), the correspondence address will remain unchanged, and the Board will continue to send correspondence to A, unless A or the party directs otherwise. [Note 3.]

If a power of attorney from a party to several attorneys (“A,” “B,” and “C”) in the same firm (“XYZ”) has been filed, and thereafter A leaves the firm but does not file a request that all future correspondence be sent to him or her, rather than to B and/or C, the Board will continue to send correspondence to B and/or C. If A, after leaving firm XYZ, does file a request that all future correspondence be sent to him or her, rather than to B and/or C, the correspondence address will be changed as requested. If, however, B and C object, and maintain that it is they, rather than A, who continue to represent the party and are entitled to receive correspondence, proceedings in the case will be suspended until a designation of correspondence address by the party has been submitted.

If oppositions or petitions for cancellation filed by different opposers or petitioners against the same application or registration are consolidated, or if an opposition or petition for cancellation is filed by joint opposers or petitioners, and the different plaintiffs are represented by different attorneys or other authorized representatives, rather than by the same one(s), the Board, in its discretion, may request that the plaintiffs appoint one lead counsel, to whom the Board may send correspondence intended for the plaintiffs. [Note 4.] After the lead counsel has been appointed, the Board will send one copy of any forthcoming Board order, decision, or other communication to the applicant or its attorney or other authorized representative, and one copy to plaintiffs' lead counsel. Lead counsel in turn will be responsible for making and distributing copies of such Board correspondence to each plaintiff or its attorney or other authorized representative. In these cases, the lead counsel is not substituted for the separate counsel of each plaintiff, but rather is responsible for coordinating the conduct of the plaintiffs' cases. A Board action requesting the appointment of lead counsel normally includes a detailed explanation of the anticipated duties and responsibilities of lead counsel.

In special circumstances, the Board, in its discretion, may send a particular item of correspondence to more than one address on behalf of a single party. However, the Board will not send correspondence to more than one address on behalf of a single party on a continuing basis.

#### **NOTES:**

1. *See* 37 CFR § 2.18.
2. *See* TMEP § 604.03.

3. See TMEP § 604.03.

4. *Cf. Internet Inc. v. Corp. for Nat'l Research Initiatives*, 38 USPQ2d 1435, 1436 n.2 (TTAB 1996) (in three proceedings where defendant in one case was one of two plaintiffs in the two other cases, and where each plaintiff retained separate counsel, Board indicated that it would send correspondence to attorneys for the plaintiff which was a party to all three cases unless otherwise advised).

### **117.03 Continuation of Correspondence With Representative in Application or Registration When Inter Partes Proceeding Commences**

In the case of a party whose application is the subject of a Board proceeding, any appearance or power of attorney (or designation of other authorized representative) of record in the application file at the time of the commencement of the Board proceeding is considered to be effective for purposes of the proceeding, and correspondence will be sent initially to that address, [Note 1] including applicant's e-mail address, if electronic communication with the Office has been authorized. Thereafter, the correspondence address may be changed in appropriate circumstances.

However, in the case of a party whose registration is the subject of a proceeding before the Board, any representation which may be of record in the registration file at the time of the commencement of the Board proceeding is not considered to be effective for purposes of the Board proceeding. Rather, correspondence is sent to the registrant itself or its domestic representative unless and until an attorney makes an appearance in the Board proceeding in the registrant's behalf, or a written power of attorney is filed in the proceeding by the registrant, or written authorization of some other person entitled to be recognized is filed in the proceeding by the registrant, or the registrant designates in writing another address to which correspondence is to be sent. [Note 2.]

Changes of attorney addresses or powers of attorney in registration files are accepted by the Office when submitted with post-registration filings, such as those under Trademark Act § 7, Trademark Act § 8, Trademark Act § 9 or Trademark Act § 15, 15 U.S.C. § 1057, 15 U.S.C. § 1058, 15 U.S.C. § 1059 or 15 U.S.C. § 1065, as well as in a cancellation or concurrent use proceeding before the Board. The attorney representing the registrant is responsible for insuring that registrant's correspondence address is updated. The Office accepts separate written address changes for registrants and domestic representatives, but global changes of address (when one paper is filed listing all involved registrations) will not be effective in changing the address in each file. A single TEAS [Note 3] form for recording a change of address, found at [www.uspto.gov/teas/e-TEAS/index.html](http://www.uspto.gov/teas/e-TEAS/index.html), can be used to notice a change of address for more than one application or registration. The TEAS form can be used to change the correspondence address only on applications or registrations that are currently active. [Note 4.]

#### **NOTES:**

1. 37 CFR § 2.105(c).

2. See 37 CFR § 2.113(c), 37 CFR § 2.18(d).
3. TEAS is the acronym for the Trademark Electronic Application System. 37 CFR § 2.2(f).
4. See TMEP § 605.01.

#### **117.04 Continuation of Correspondence with Representative of Potential Opposer After Opposition is Filed**

When an attorney is appointed in a power of attorney accompanying an opposition, or makes an appearance by filing an opposition on behalf of the opposer, the Board will send correspondence to that attorney, notwithstanding the fact that another attorney or attorneys may have obtained one or more extensions of time to oppose on behalf of the opposer. If, however, a power of attorney filed with an opposition names several attorneys, and there is no transmittal letter and no other indication as to which of them is to have primary responsibility for the case and receive correspondence, but one of the named attorneys obtained an extension of time to oppose, correspondence will be sent to that attorney; if none of the named attorneys obtained an extension of time to oppose, correspondence will be sent to the first named attorney. Thereafter, the correspondence address may be changed in appropriate circumstances.

#### **117.05 Correspondence After Revocation or Withdrawal**

If the authority of an attorney or other authorized representative to represent a party in a proceeding before the Board is revoked, or the practitioner is granted permission to withdraw upon request therefor to the Board, and the party is not represented by any other practitioner, correspondence will be sent to the party at its address of record unless another practitioner puts in an appearance, or a written appointment of another practitioner is filed, or the party designates in writing another address to which correspondence is to be sent.

#### **117.06 Correspondence With Foreign Party**

If a party to a Board proceeding is not domiciled in the United States and is not represented by an attorney or other authorized representative located in the United States, or by a foreign attorney or agent duly qualified under 37 CFR § 11.14(c), correspondence will be sent to the party's domestic representative, if one has been appointed. Note, however, that a domestic representative cannot represent a party in Board proceedings. [Note 1.] If the party has not appointed a domestic representative and the proceeding is not being prosecuted by an attorney or other qualified person, the Office will send correspondence directly to the party, unless the party designates in writing another address to which correspondence is to be sent. [Note 2.]

#### **NOTES:**

1. See TMEP § 610.
2. See 37 CFR § 2.119(d).

## **117.07 Change of Address**

If a party to a Board proceeding or its attorney or other authorized representative moves or changes its e-mail address, a separate written notice of the change of address or e-mail address should be filed with the Board and should reference the proceeding number. It is the responsibility of a party to a proceeding before the Board to ensure that the Board has the party's current correspondence address, including an e-mail address, if applicable. If a party fails to notify the Board of a change of address, with the result that the Board is unable to serve correspondence on the party, default judgment may be entered against the party.

A party or its attorney or other authorized representative should not assume that the inclusion of a new address or e-mail address on a document directed to another matter, or on the envelope in which a paper is filed, is sufficient to notify the Board of a change of address. Paper correspondence sent by mail to the Office is opened in the USPTO Mail Room, and ordinarily the envelopes are discarded there before the mail is sent on to its ultimate destination within the Office. Thus, the Board rarely sees the return addresses on the mailing envelopes of papers filed in Board proceedings. Moreover, while it is the normal practice of the Board to check the address on newly filed papers and to change its records to reflect any noted change of address, the Board has no obligation to do so. The responsibility for any failure to receive correspondence due to a change of address of which the Board has not been given separate written notice lies with the party or its attorney or other authorized representative.

The best practice is to promptly file a separate change of address with the Board when the correspondence address, including an e-mail address, for any party to a Board proceeding changes. Parties are encouraged to file a change of address online using ESTTA, where they are able to enter the new address.

## **117.08 Individual Not Entitled to Represent Others**

An individual who is not entitled, under 37 CFR § 11.14(a), 37 CFR § 11.14(b), 37 CFR § 11.14(c) or 37 CFR § 11.14(e), to practice before the Office in trademark cases, will not be permitted to represent a party in a proceeding before the Board, and may not file submissions on behalf of the party. [Note 1.] If it comes to the attention of a Board attorney that such an individual is attempting to represent a party in a Board proceeding, the Board attorney will bring the matter to the attention of the Chief Administrative Trademark Judge, who will coordinate appropriate action with the Office of Enrollment and Discipline. Moreover, no Board correspondence intended for the party will be sent to the individual. Rather, the Board will send such correspondence to the party itself, or to the party's attorney or other authorized representative entitled to practice before the USPTO in trademark cases. [Note 2.]

### **NOTES:**

1. See TMEP § 602 (Person Authorized to Practice Before USPTO in Trademark Matters).
2. See 37 CFR § 2.18.

## 118 Payment of Fees

### 118.01 Lists of Fees and Charges

A list of the fees and charges established by the USPTO for trademark cases may be found in 37 CFR § 2.6, and online at the USPTO's website, [www.uspto.gov](http://www.uspto.gov).

A list of fees and charges established by the USPTO for miscellaneous services may be found in 37 CFR § 1.21, as well as on the USPTO web site.

A list of fees and charges for processing correspondence relating to international applications and registrations under the Madrid Protocol may be found in 37 CFR § 7.6 as well as on the USPTO web site. International fees that may be paid to the International Bureau of the World Intellectual Property Organization through the Office in connection with international applications and registrations may be found in 37 CFR § 7.7 as well as on the WIPO web site, [www.wipo.int](http://www.wipo.int).

### 118.02 Fees Payable in Advance

#### **37 CFR § 2.206 Trademark Fees payable in advance.**

*(a) Trademark fees and charges payable to the Office are required to be paid in advance; that is, at the time of requesting any action by the Office for which a fee or charge is payable.*

*(b) All fees paid to the Office must be itemized in each individual trademark application, or registration file, or trademark proceeding, so the purpose for which the fees are paid is clear. The Office may return fees that are not itemized as required by this paragraph.*

#### **37 CFR § 2.101 Filing an opposition.**

*(a) An opposition proceeding is commenced by filing in the Office a timely notice of opposition with the required fee.*

\* \* \* \*

*(d)(1) The opposition must be accompanied by the required fee for each party joined as opposer for each class in the application for which registration is opposed (see § 2.6).*

*(2) An otherwise timely opposition will not be accepted via ESTTA unless the opposition is accompanied by a fee that is sufficient to pay in full for each named party opposer to oppose the registration of a mark in each class specified in the opposition.*

*(3) If an otherwise timely opposition is submitted on paper, the following is applicable if less than all required fees are submitted:*

*(i) If the opposition is accompanied by no fee or a fee insufficient to pay for one person to*



*oppose the registration of a mark in at least one class, the opposition will be refused.*

*(ii) If the opposition is accompanied by fees sufficient to pay for one person to oppose registration in at least one class, but fees are insufficient to oppose registration in all the classes in the application, and the particular class or classes against which the opposition is filed is not specified, the opposition will be presumed to be against the class or classes in ascending numerical order, including only the number of classes in the application for which sufficient fees have been submitted.*

*(iii) If persons are joined as party opposers, each must submit a fee for each class for which opposition is sought. If the fees submitted are sufficient to pay for one person to oppose registration in at least one class, but are insufficient for each named party opposer, the first-named party will be presumed to be the party opposer. Additional parties will be deemed to be party opposers only to the extent that the fees submitted are sufficient to pay the fee due for each party opposer. If persons are joined as party opposers against a multiple class application, the fees submitted are insufficient, and no specification of opposers and classes is made at the time the party is joined, the fees submitted will be applied first on behalf of the first-named opposer against as many of the classes in the application as the submitted fees are sufficient to pay. Any excess will be applied on behalf of the second-named party to the opposition against the classes in the application in ascending numerical order.*

*(4) The filing date of an opposition is the date of receipt in the Office of the notice of opposition, with proof of service on the applicant, or its attorney or domestic representative of record, if one has been appointed, at the correspondence address of record in the Office, and the required fee, unless the notice is filed in accordance with § 2.198.*

### **37 CFR § 2.111 Filing petition for cancellation.**

*(a) A cancellation proceeding is commenced by filing in the Office a timely petition for cancellation with the required fee.*

\* \* \* \*

*(c)(1) The petition for cancellation must be accompanied by the required fee for each party joined as petitioner for each class in the registration for which cancellation is sought (see § 2.6).*

*(2) An otherwise timely petition for cancellation will not be accepted via ESTTA unless the petition for cancellation is accompanied by a fee that is sufficient to pay in full for each named party petitioner to petition for cancellation of the registration of a mark in each class specified in the petition for cancellation.*

*(3) If an otherwise timely petition for cancellation is submitted on paper, the following is applicable if less than all required fees are submitted:*

*(i) If the petition for cancellation is accompanied by no fee or a fee insufficient to pay for one person to petition for cancellation against at least one class in the registration, the petition for*

*cancellation will be refused.*

*(ii) If the petition for cancellation is accompanied by fees sufficient to pay for one person to petition for cancellation against at least one class in the registration, but fees are insufficient for a petition for cancellation against all the classes in the registration, and the particular class or classes against which the petition for cancellation is filed is not specified, the petition for cancellation will be presumed to be against the class or classes in ascending numerical order, including only the number of classes in the registration for which sufficient fees have been submitted.*

*(iii) If persons are joined as party petitioners, each must submit a fee for each class for which cancellation is sought. If the fees submitted are sufficient to pay for one person to petition for cancellation of the registration in at least one class but are insufficient for each named party petitioner, the first-named party will be presumed to be the party petitioner. Additional parties will be deemed to be party petitioners only to the extent that the fees submitted are sufficient to pay the fee due for each party petitioner. If persons are joined as party petitioners against a multiple class registration, the fees submitted are insufficient, and no specification of parties and classes is made at the time the party is joined, the fees submitted will be applied first on behalf of the first-named petitioner against as many of the classes in the registration as the submitted fees are sufficient to pay. Any excess will be applied on behalf of the second-named party to the cancellation against the classes in the registration in ascending numerical order.*

*(4) The filing date of a petition for cancellation is the date of receipt in the Office of the petition for cancellation, with proof of service on the owner of record, or on the owner's domestic representative, if one has been appointed, at the correspondence address of record in the Office, and with the required fee, unless the petition is filed in accordance with § 2.198.*

The filing fee for an opposition or cancellation proceeding must be tendered with the notice of opposition or petition for cancellation. A notice of opposition or petition for cancellation filed without a filing fee will not be accorded a filing date. [Note 1.]

When a notice of opposition or petition for cancellation is filed using ESTTA, the correct fee will be calculated and payment must be made before the filing will be transmitted to the USPTO. Note that in order for fees to be properly calculated, each opposer or petitioner must be entered separately. [Note 2.]

If an otherwise timely notice of opposition or petition for cancellation is submitted on paper with less than the full fee due, it will not be refused a filing date provided that the fee paid is sufficient for at least one opposer or petitioner to proceed against at least one class. If the classes to be opposed are not specified, the fee tendered will be applied to the classes of the subject application or registration, in ascending order, on behalf of the opposers or petitioners in the order they were named. [Note 3.]

## **NOTES:**

1. 37 CFR § 2.101(d)(4) and 37 CFR § 2.111(c)(4).

2. See *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 n.2 (TTAB 2009) (multiple opposers not entered separately in ESTTA, resulting in improper fee being calculated and paid; opposition considered to be properly filed by first-named opposer only).

3. See 37 CFR § 2.111(c)(3).

## **118.03 Method of Payment--In General**

### **37 CFR § 2.207 Method of payment.**

*(a) All payments of money required in Trademark cases, including fees for the processing of international trademark applications and registrations that are paid through the Office, shall be made in U.S. dollars and in the form of a cashier's or certified check, Treasury note, national bank note, or United States Postal Service money order. If sent in any other form, the Office may delay or cancel the credit until collection is made. Checks and money orders must be made payable to the Director of the United States Patent and Trademark Office. (Checks made payable to the Commissioner of Patents and Trademarks will continue to be accepted.) Payments from foreign countries must be payable and immediately negotiable in the United States for the full amount of the fee required. Money sent to the Office by mail will be at the risk of the sender, and letters containing money should be registered with the United States Postal Service.*

*(b) Payments of money required for trademark fees may also be made by credit card except for replenishing a deposit account. Payment of a fee by credit card must specify the amount to be charged to the credit card and such other information as is necessary to process the charge, and is subject to collection of the fee. The Office will not accept a general authorization to charge fees to a credit card. If credit card information is provided on a form or document other than a form provided by the Office for the payment of fees by credit card, the Office will not be liable if the credit card number becomes public knowledge.*

It is the practice of the Office to routinely accept, as "conditional" payment of a fee, a signed uncertified check. If such a check is returned for insufficient funds, the fee remains unpaid, and the filing date of the fee will be the filing date of any resubmitted adequate payment. [Note 1.] An unsigned check will be returned to its sender, but the Director has the discretion to accept such a check, as "conditional" payment, upon petition showing sufficient cause therefor. [Note 2.]

The Office cannot accept U.S. Treasury checks that have been issued to the applicant or to another party as payment of Office fees. This is true for all refund checks whether issued from the Office or any other government agency. Office rules require that money orders and checks be made payable to the Director of Patents and Trademarks and do not permit the acceptance of U.S. Treasury checks endorsed by the applicant in payment of fees.

Filers using ESTTA to file papers with the Board online will be prompted to pay any necessary fees as a part of the ESTTA filing process. When paying a fee through ESTTA, filers may

utilize a credit card, electronic funds transfer, or a USPTO deposit account.

**NOTES:**

1. *See In re Cantatore*, 231 USPQ 742, 744 (Comm'r 1986) (petition to revive was denied because filing fee check was returned for insufficient funds).
2. *See Dubost v. U.S. Patent and Trademark Office*, 777 F.2d 1561, 227 USPQ 977, 980 (Fed. Cir. 1985) (Office has discretion), *on remand*, *In re Dubost*, 231 USPQ 887, 889 (Comm'r 1986) (sufficient cause not shown).

## **118.04 Method of Payment--Deposit Accounts**

For the convenience of attorneys and the general public in paying fees and charges to the Office, deposit accounts may be established in the Office. [Note 1.] The Office has an automated financial system, the Revenue Accounting and Management (RAM) system, that allows transactions to occur over the Internet through the Office web site at [www.uspto.gov](http://www.uspto.gov). Deposit accounts can be maintained through the Internet and funds replenished by check or electronic funds transfer. [Note 2.] A deposit account may be used for payment of any necessary fee when filing online using ESTTA, or when filing paper documents.

The fees for filing an ex parte appeal to the Board, an opposition, and a petition for cancellation, may all be charged to a deposit account, provided that the requirements of 37 CFR § 2.208 are met. However, the charging of a fee against an account that does not contain sufficient funds to cover it cannot be regarded as payment of the fee. [Note 3.] Thus, the overdrawing of a deposit account may result in the loss of a vital date.

The Office will not accept ex parte appeals if the notice of appeal is not accompanied by at least a \$100 fee or specific authorization to charge the deposit account for that fee, as opposed to a general authorization which may have been provided when the application was filed. A general authorization to charge a deposit account will only be effective upon petition to the Director. [Note 4.] Because the general authorization can only be invoked on petition, the Board itself cannot accept the general authorization as a basis for treating the appeal fee as timely submitted.

**NOTES:**

1. *See* 37 CFR § 2.208 (Deposit accounts).
2. 37 CFR § 2.208(c).
3. *See* 37 CFR § 2.208(b).
4. *In re Sky is the Ltd.*, 42 USPQ2d 1799, 1800 (Comm'r 1996) ("Requiring the Office mailroom and the ITU/Divisional Unit of the Office to check each application file for a general authorization to charge a deposit account would place an undue and unmanageable burden on those sections of the Office.").

## **119 Papers and Fees Generally Not Returnable**

### **119.01 Fee Refunds--General Rule**

#### **37 CFR § 2.209 Refunds.**

*(a) The Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a trademark application, appeal or other trademark filing for which the fee was paid, will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested, and will not notify the payor of such amounts. If a party paying a fee or requesting a refund does not provide the banking information necessary for making refunds by electronic funds transfer (31 U.S.C. § 3332 and 31 CFR part 208), or instruct the Office that refunds are to be credited to a deposit account, the Director may require such information, or use the banking information on the payment instrument to make a refund. Any refund of a fee paid by credit card will be by a credit to the credit card account to which the fee was charged.*

*(b) Any request for refund must be filed within two years from the date the fee was paid, except as otherwise provided in this paragraph. If the Office charges a deposit account by an amount other than an amount specifically indicated in an authorization (§ 2.208(b)), any request for refund based upon such charge must be filed within two years from the date of the deposit account statement indicating such charge, and include a copy of that deposit account statement. The time periods set forth in this paragraph are not extendable.*

### **119.02 Papers and Fees--Ex Parte Cases**

After an application has received a filing date, papers filed in connection therewith, including ex parte appeal papers, will not be returned. [Note 1.]

If a notice of appeal to the Board from an examining attorney's final refusal is late filed, the appeal will not be entertained, the application will be abandoned, the notice of appeal will be retained in the Board's file, and any appeal fee submitted therewith will be refunded. If a notice of appeal is filed prematurely, the appeal will not be entertained, the notice of appeal will be retained in the Board's file, the application will be returned to the examining attorney for further appropriate action, and applicant will be advised that if a timely appeal is subsequently filed in the case, any fee submitted with the premature appeal will be applied thereto, or, if no timely appeal is filed, applicant may request a refund of any such fee.

If a final refusal to register is withdrawn by the examining attorney, and the application is approved for publication, following which the applicant, not knowing that the application has been approved for publication, files a notice of appeal, the appeal will not be instituted, the notice of appeal will be retained in the Board's file, and any appeal fee submitted therewith will be refunded. In such a case, the notice of appeal, and appeal fee, are considered to have been filed in excess, rather than by change of purpose, since at the time of its filing, the appeal was unnecessary. If, however, the examining attorney withdraws the refusal to register, and approves

the application for publication after an appeal to the Board has been filed, the appeal will be dismissed as moot, and the appeal fee will not be refunded (the appeal having been necessary at the time of its filing).

#### NOTES:

1. *See* 37 CFR § 2.25 (Documents not returnable).

### **119.03 Papers and Fees--Inter Partes Cases**

After an inter partes proceeding before the Board has been filed, papers and other materials filed in connection therewith, normally will not be returned. Following the conclusion of a proceeding, including any appeal period, a party which filed confidential paper materials pursuant to a protective order will be given the choice to have those materials returned, or to have them destroyed by the Board. *See* TBMP § 806 (Termination of Proceeding). The Board will retain electronic versions of all submissions pursuant to USPTO document retention policies. Confidential submissions will remain sealed after termination of the proceeding. If, because of a defect in an opposition or a petition for cancellation filed with the Board, a proceeding is not instituted, any submitted fee will be refunded.

No proceeding will be instituted, and any submitted filing fee will be refunded in the following circumstances:

- (1) If an opposition filed during an extension of time to oppose is in the name of someone other than the person who obtained the extension, and the opposer is unable to show, pursuant to 37 CFR § 2.102(b), that it is in privity with the person who obtained the extension, or that the person in whose name the extension was requested was misidentified by mistake.
- (2) If an opposition or a petition for cancellation is filed prematurely (i.e., prior to publication of the subject mark in the Official Gazette for purposes of opposition, or prior to issuance of a registration of the subject mark, respectively, even if the registration has issued by the time of the Board's action).
- (3) If an opposition is filed after the time for opposing has expired; or, is filed unsigned, and a signed copy is not submitted within the time limit set in the notification of this defect by the Board; or is filed without the required fee; or if the opposed application was abandoned before the opposition was filed. *See* TBMP § 218 (Abandonment of Application).

Electronic filings will not be accepted if any of the above-identified conditions exist.

Proceedings will be instituted, and the filing fee charged in the following circumstances:

- (1) If a petition to cancel a Principal Register registration that is more than five years old does not allege any ground upon which such a registration can be cancelled (*see* Trademark Act § 14, 15 U.S.C. § 1064), the cancellation will be instituted and the Board will issue an order to show cause why the petition should not be dismissed for failure to state a claim. Note that when filing

a petition for cancellation online using ESTTA, time-barred grounds for cancellation are not presented as an option.

(2) If a petition for cancellation is filed with respect to a registration which, at the time of the filing of the petition, was not a “live” registration (e.g., the time for filing an affidavit of use under Trademark Act § 8, 15 U.S.C. § 1058, had expired, and no acceptable affidavit had been filed; the registration had already been cancelled as the result of a previous cancellation proceeding), the proceeding will be instituted, and then dismissed as moot.

(3) If a party files an opposition or a petition for cancellation, and immediately thereafter changes its mind, and requests that the opposition or petition for cancellation not be instituted and that the papers be returned, the request ordinarily will be denied, and the proceeding will be instituted, unless there is a defect in the opposition or petition for cancellation which precludes institution, in which case no proceeding will be instituted, and any submitted fee will be refunded.

When the Board finds that it erroneously instituted a proceeding, the proceeding will be dismissed as a nullity. A refund will be issued in most circumstances involving dismissal as a nullity (e.g., institution of duplicate proceedings). All submissions will be retained by the Board under the assigned proceeding number, pursuant to the applicable retention policy.

## **120 Access to Files**

**37 CFR § 2.27(d)** *Except as provided in paragraph (e) of this section, the official records of applications and all proceedings relating thereto are available for public inspection and copies of the documents may be furnished upon payment of the fee required by § 2.6.*

**37 CFR § 2.27(e)** *Anything ordered to be filed under seal pursuant to a protective order issued or made by any court or by the Trademark Trial and Appeal Board in any proceeding involving an application or a registration shall be kept confidential and shall not be made available for public inspection or copying unless otherwise ordered by the court or the Board, or unless the party protected by the order voluntarily discloses the matter subject thereto. When possible, only confidential portions of filings with the Board shall be filed under seal.*

### **120.01 Non-confidential Files**

Except for materials filed under seal pursuant to a protective order or agreement, all pending Board proceeding files and exhibits thereto are available for public inspection and copying. [Note 1.] Most Board records since 2001 are electronic. The electronic records of the Board are accessible via TTABVUE on the Board’s home page of the USPTO web site at <http://ttabvue.uspto.gov/>. The electronic record of applications and registrations, which are the subject matter of pending proceedings before the Board, and extensions of time to oppose are accessible via the Internet at <http://tarr.uspto.gov/>.

Board records submitted prior to approximately 2001 are kept in paper. An individual who wishes to inspect or copy one of the paper files that are located at the Board or one of the

USPTO Warehouses may place a request for access to a particular Board file with the Trademark Assistance Center, located at 600 Dulany Street, Madison East Concourse Level, Room C55, Alexandria, Virginia. Requests for access may be made using the self-service electronic File Ordering System or by logging such in the Public Access Log Book located in the Trademark Assistance Center public access area. A Trademark Assistance Center employee is available to assist customers desiring to place requests for access to Board files.

An individual who wishes to inspect or copy a paper file located at the Board may also contact a Board Customer Service Representative at (571) 272-8500 or (800) 786-9199 (toll free), and ask that the file be located. When the file has been located, the Board will deliver the file to the Trademark Assistance Center and will notify the customer that the file has been delivered and is available for access at the Trademark Assistance Center, 600 Dulany Street, Madison East Concourse Level, Room C55, Alexandria, Virginia.

Paper files which have been ordered and received for customers will be held at the Trademark Assistance Center customer service window for a period of two weeks to enable the customer to return to inspect or copy the ordered files. Customers may copy pages from the files using the photocopier designated for public use which is located in the Trademark Assistance Center public access area by using a magnetic card to charge the fees for the copies. The magnetic card, known as a “copy card” may be purchased from the cashier at the USPTO Public Search Facility, located at 600 Dulany Street, Madison East, 1st Floor, Alexandria, Virginia.

Paper files or portions thereof may not be taken from the premises of the Trademark Assistance Center and a person who removes papers from a file for copying must return the papers to the file in their proper order.

For information concerning access to the paper files of cases that are on appeal from a decision of the Board, *see* TBMP § 904.

#### **NOTES:**

1. *See* 37 CFR § 2.27.

### **120.02 Confidential Materials**

Materials filed with the Board under seal pursuant to the Board’s standard protective order, or a protective agreement signed by the parties, or a protective order entered by the Board or any court and filed in compliance with TBMP § 412.04, will be kept confidential and will not be made available for public inspection or copying unless otherwise ordered by the court or the Board, or unless the party protected by the order voluntarily discloses the matter subject thereto. [Note 1.] These materials may be inspected only by those individuals who are entitled, under the terms of the protective order, to have access to the protected information. [Note 2.] *See* TBMP § 412. (Protective Orders), TBMP § 526 (Motion for Protective Order), TBMP § 703.01(p) (Confidential or Trade Secret Material). To be handled as confidential, and kept out of the public record, confidential materials must be so designated at the time of filing. Paper or electronic submissions in Board proceedings which are not properly designated as confidential



will be placed in the Board's public records, available on the Internet.

Electronic filing using ESTTA is preferred for submissions containing confidential material. When using ESTTA, the filer should select "CONFIDENTIAL Opposition, Cancellation or Concurrent Use" under "File Documents in a Board Proceeding." [Note 3.] Filings made using this option will not be made available for public viewing, although an entry will be made on the publicly-available docket sheet in TTABVUE.

If a paper submission contains confidential material, it must be submitted under separate cover. Both the submission and its cover must be marked confidential and must identify the case number and the parties.

The parties are strongly discouraged from submitting materials which contain the personally identifiable information of an individual (e.g., account numbers, social security number, home addresses, and home phone numbers). The parties are also discouraged from submitting unnecessary information (e.g., payroll) that may lead to identity theft or other fraudulent use of such information, even where such information concerns a business but may not be addressed in either the Board's standard protective order or a stipulated protective agreement between the parties. If such information is embedded in the materials being submitted, such privacy information is to be redacted.

Except for materials filed under seal pursuant to a protective order or agreement, all Board proceeding files and exhibits thereto are available for public inspection and copying. Therefore, only the particular discovery responses, exhibits, deposition transcript pages, or those portions of a brief, pleading or motion that disclose confidential information should be filed under seal pursuant to a protective order. [Note 4.] A good practice would be to clearly mark as "confidential" each page of a submission that contains such matter.

However filed, if a party submits any brief, pleading, motion or other such filing containing confidential information under seal, the party must also submit for the public record a redacted version of said papers. [Note 5.]

#### **NOTES:**

1. See 37 CFR § 2.120(g) ("The Trademark Trial and Appeal Board's standard protective order is applicable during disclosure, discovery and at trial in all opposition, cancellation, interference and concurrent use registration proceedings, unless the parties, by stipulation approved by the Board, agree to an alternative order, or a motion by a party to use an alternative order is granted by the Board. The standard protective order is available at the Office's Web site, or upon request, a copy will be provided.").

2. See 37 CFR § 2.27(e); 37 CFR § 2.120(f); 37 CFR § 2.125(e).

3. See <http://estta.uspto.gov/filing-type.jsp>. This option is only available for filing documents in an existing opposition, cancellation, or concurrent use proceeding. Since a notice of opposition or petition for cancellation provides only notice of a claim and general facts in support of it, there

should rarely, if ever, be occasion to file confidential material with a notice or petition. The existence of the proceeding itself will not be treated as confidential.

4. See 37 CFR § 2.126(c); *Duke University v. Haggard Clothing Co.*, 54 USPQ2d 1443, 1445 (TTAB 2000).

5. See 37 CFR § 2.126(c).

### **120.03 Files of Terminated Proceedings**

When an inter partes proceeding has been finally determined, i.e., when the proceeding is over (including the resolution of any direct court review), the Office takes certain further steps based on the final decision, including those steps necessary to give effect to the decision. This process is referred to as the “termination” of the proceeding. See TBMP § 806 (Termination of Proceeding).

Beginning in 2001, the Board began to create and maintain electronic files for Board proceedings. The official records for all Board proceedings are now kept electronically. The electronic files of all Board proceedings continue to remain available online through TTABVue after termination.

Pursuant to the National Archives retention schedule, terminated paper inter partes proceeding files that result in a final decision by the Board, e.g., a granted motion for summary judgment or motion to dismiss, or a final decision on the merits, are transferred to a USPTO warehouse for 3 years, then to the Washington National Records Center in Suitland, Maryland for 27 years, and then to the National Archives for permanent retention. All other terminated paper proceedings are transferred to a USPTO warehouse for 3 years and then transferred to the Washington National Records Center in Suitland, Maryland, where they remain for 27 years before destruction. The paper files of existing registrations are also stored at the warehouse for as long as they remain registered. The paper files of cancelled and expired registrations are destroyed three years after the date of cancellation or expiration; the paper files of abandoned applications are destroyed three years after the date of abandonment. In addition, the paper files of terminated opposition proceedings numbered from 30,000 through 53,999, and of terminated cancellation proceedings numbered from 1 through 9399, have been destroyed.

An individual who wishes to inspect or copy a paper file stored by the Office in a USPTO warehouse may place a request for access to a particular file with the Trademark Assistance Center, located at 600 Dulany Street, Madison East Concourse Level, Room C55, Alexandria, Virginia. Requests for access may be made using the self-service electronic File Ordering System or by logging them in the Public Access Log Book located in the Trademark Assistance Center public access area. A Trademark Assistance Center employee is available to assist customers desiring to place requests for access to Board files.

Paper files which have been ordered and received for customers will be held at the Trademark Assistance Center customer service window for a period of two weeks to enable the customer to return to inspect or copy the ordered files. Customers may copy pages from the files using the

photocopier designated for public use which is located in the Trademark Assistance Center public access area by using a prepaid magnetic card to charge the fees for the copies. The magnetic card, known as a “copy card” may be purchased from the cashier at the USPTO Public Search Facility, which is located at 600 Dulany Street, Madison East, 1st Floor, Alexandria, Virginia. The file may not be removed from the premises of the Trademark Assistance Center, and a person who removes papers from a file for copying must return the papers to the file in their proper order. [Note 1.]

#### NOTES:

1. See TMEP § 109.02.

## 121 Copying of Files

Most records filed in Board proceedings since 2001 are kept electronically. Non-electronic records are kept in paper files pursuant to the relevant retention schedule. When used, paper files are kept at the Board during the pendency of the Board proceeding, then stored at a warehouse pursuant to the relevant retention schedule. See TBMP § 120.03.

The electronic files of the Board are accessible on the Internet via TTABVUE. [Note 1.] The electronic files of applications and registrations which are the subject matter of pending proceedings before the Board are accessible online via TDR (Trademark Document Retrieval). [Note 2.] Both TTABVUE and TDR permit users to view, download, and print non-confidential portions of applications, registrations, and Board proceedings.

Copies of Board non-electronic (i.e., paper) files may be obtained by requesting the file, *see* TBMP § 120, and utilizing the photocopier designated for public use in the Trademark Assistance Center public access area by using a magnetic card to charge the fees for the copies. [Note 3.] The magnetic card, known as a “copy card” may be purchased from the cashier at the USPTO Public Search Facility, which is located at 600 Dulany Street, Madison East, 1st Floor, Alexandria, Virginia.

Paper files or portions thereof may not be taken from the premises of the Trademark Assistance Center and a person who removes papers from a file for copying must return the papers to the file in their proper order.

Alternatively, the Patent and Trademark Copy Fulfillment Branch, Public Records Division will furnish photocopies (either certified or uncertified) of trademark application and registration files, or of one or more papers therefrom, or of papers from the files of Board proceedings, upon written request and payment of the fee prescribed in 37 CFR § 2.6. The Office will also furnish, upon written request and payment of the fee prescribed in 37 CFR § 2.6, printed copies of trademark registrations, certified copies of registrations with information as to the current status and title of the registration, and abstracts of title to trademark applications and registrations.

All requests for certified and uncertified copies of trademark documents relating to applications or registrations, including copies of papers from the files of Board proceedings, and abstracts of

title, are handled by the Patent and Trademark Copy Fulfillment Branch, Public Records Division. Copies can be ordered online from the Office of Public Records at <http://ebiz1.uspto.gov/oems25p/index.html>, by e-mail to [dsd@uspto.gov](mailto:dsd@uspto.gov), and by telephone at (571) 272-3150 or (toll free) (800) 972-6382. A request (with the required fee) made by postal mail for copies should be addressed to Mail Stop Document Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450. The written request, with fee, may also be hand delivered to the Public Service Window at 2800 South Randolph Street, Randolph Square Building, 3rd Floor, Arlington, Virginia 22206-2217. Finally, if the written request includes an authorization to charge the required fee to a deposit account, the request may be sent by facsimile transmission to (571) 273-3250. [Note 4.]

## NOTES:

1. <http://ttabvue.uspto.gov/>.
2. <http://tmportal.uspto.gov/external/portal/tow>.
3. See 37 CFR § 2.6(b)(9) (current charge for self-service copies is \$.25 per page).
4. See *Notice of a Change in Procedure Regarding Requests for Certification Services*, 1165 TMOG 13 (Aug. 2, 1994).

## 122 Certification

### 122.01 Court Requirements

If a copy of a Board proceeding file, or a portion thereof, is needed for use before a court, the court may require a certified copy (which bears a seal). This may be obtained from the Patent and Trademark Copy Fulfillment Branch, Public Records Division. See TBMP § 121 for information on ordering certified copies.

A paper cannot be certified by the Office as being a true copy of a paper filed in a Board proceeding unless and until it has, in fact, been filed therein. The paper may be filed at the same time that the request for certification is made.

### 122.02 Certified Copies

Certified copies, bearing a seal, of Office proceeding files, including Board proceeding files, or portions thereof, may be ordered from the Patent and Trademark Copy Fulfillment Branch, Public Records Division, upon written request and payment of the required fee. See TBMP § 121 for information on ordering certified copies.

## 123 Status Information for Applications, Registrations and Board Proceedings

Detailed current information about the status and prosecution history of trademark applications and registrations can be obtained online through the TARR database at <http://tarr.uspto.gov>. Information on any recorded documents affecting the title to applications or registrations can be obtained from the Trademark Assignments database at <http://assignments.uspto.gov/assignments/>.

The Trademark Assistance Center provides general information about the registration process and can also answer status questions. The Center can be reached at (800) 786-9199 (toll free) or (571) 272-9250. Trademark application and registration information can also be obtained through the Trademark Applications and Registrations Retrieval (TARR) database at <http://tarr.uspto.gov>. [Note 1.]

The status of Board proceedings and of requests for extensions of time to oppose can be obtained online using TTABVue at <http://ttabvue.uspto.gov>. General information about Board proceedings (including status information) can be obtained by calling the Trademark Trial and Appeal Board at (571) 272-8500 or (800) 786-9199 (toll free).

### NOTES:

1. See generally TMEP § 108, *et seq.* (Status Inquiries).

## 124 Action by Assignee

When a mark which is the subject of a federal application or registration has been assigned, together with the application or registration, in accordance with Trademark Act § 10, 15 U.S.C. § 1060, any action with respect to the application or registration which may or must be taken by the applicant or registrant may be taken by the assignee (acting itself, or through its attorney or other authorized representative), provided that the assignment has been recorded or that proof of the assignment has been submitted. [Note 1.] Similarly, when a mark which is not the subject of a federal application or registration, but which is owned and pleaded by a plaintiff in a Board inter partes proceeding, has been assigned, the assignee may act in the proceeding in place of the assignor, provided that proof of the assignment has been submitted in the proceeding. See TBMP § 512.01 (Assignment of Mark).

**Please note:** Trademark Act § 10, 15 U.S.C. § 1060, and part 3 of 37 CFR are not applicable to Trademark Act § 66(a), 15 U.S.C. § 1141f(a) applications and registrations. [Note 2.] Except in limited circumstances, [Note 3] requests to record assignments of § 66(a) applications and registrations must be filed directly with the International Bureau of the World Intellectual Property Organization. [Note 4.] The International Bureau will notify the USPTO of any changes in ownership recorded in the International Register. The USPTO will record only those assignments, or other documents of title, that have been recorded in the International Register. [Note 5.]

## NOTES:

1. 37 CFR § 3.71(d) (Prosecution by assignee), 37 CFR § 3.73(b) (Establishing right of assignee to take action). *See* Trademark Act § 72, 15 U.S.C. § 1141l, 37 CFR § 7.22–37 CFR § 7.24 regarding assignment of Trademark Act § 66(a), 15 U.S.C. § 1141f(a) applications and registrations.
2. TMEP § 503.05. *See* 37 CFR § 7.22–37 CFR § 7.24 for information on recording changes to applications and registrations under Trademark Act § 66(a).
3. *See* TMEP § 1906.01(a)(i).
4. 37 CFR § 7.22. *See also* TMEP § 1906, *et seq.* (Recording Changes in International Register).
5. *See* TMEP § 1906.01(a).